



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Where Patent Application of:

Joseph R. BYRUM

Application Serial No.: 09/552,087

Filed: April 21, 2000

Confirmation No.: 4196

Art Unit: 1634

Examiner: Juliet C. Switzer

Attorney Docket No.: 16517.132

Title: Nucleic Acid Molecules and Other Molecules Associated With Plants

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is an Appeal from the Final Rejection of claims in the above-captioned patent application. A Notice of Appeal was filed on February 28, 2007. Authorization to charge the official fees for this filing is given in the accompanying transmittal letter.

**1. Real Party in Interest**

The real party in interest is Monsanto Company, a Delaware corporation with offices at 800 North Lindbergh Boulevard, St. Louis, Missouri 63167.

**2. Related Appeals and Interferences**

Appellant identified the following judicial proceeding, which may have a bearing on the Board's decision in the present Appeal. On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the United States Court of Appeals for the Federal

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Circuit ("Federal Circuit") from a decision by the Board in *In re Fisher* (U.S. Patent Application Serial No. 09/619,643; BPAI Appeal No. 2002-2046; Federal Circuit Case No. 04-1465). The Federal Circuit's decision in *In re Fisher* may have a bearing on the Board's decision with regard to at least one of the grounds of rejection in the present appeal. A copy of the Board's decision in Appeal No. 2002-2046, *Ex parte Fisher*, 72 U.S.P.Q.2d 1020 (Bd. Pat. App. Int. 2004), and a copy of *In re Fisher*, 421 F.3d 1365 (Fed. Cir. 2005) are attached hereto in the Related Proceedings Appendix.

Appellant filed an appeal in the current application on January 12, 2004. The decision by the Board on this appeal, BPAI Appeal No. 2004-1772, was mailed on December 30, 2004. A copy of this decision is attached.

The Real Party in Interest filed an Appeal Brief in U.S. Patent Application Serial No. 09/684,016; in U.S. Patent Application Serial No. 10/361,942; in U.S. Patent Application Serial No. 09/199,129; in U.S. Patent Application Serial No. 09/920,953; in U.S. Patent Application Serial No. 09/663,423; in U.S. Patent Application Serial No. 09/237,183; in U.S. Patent Application Serial No. 09/692,257; in U.S. Patent Application Serial No. 10/437,963; and in U.S. Patent Application Serial No. 09/531,113; which also may have a bearing on the present appeal.

### **3. Status of Claims**

Claims 3, 5 to 7, 9, 10 and 12 to 20 are pending. Claims 1, 2, 4, 8, and 11 were cancelled by Appellant, without prejudice to, or disclaimer of, the underlying subject matter, in responses dated February 19, 2002 and January 3, 2003. Claims 3, 5 to 7, 9, 10 and 12 to 20 stand finally rejected under 35 U.S.C. §§ 101 and 112, first paragraph. Appellant appeals the rejections of claims 3, 5 to 7, 9, 10 and 12 to 20.

#### **4. Status of Amendments**

On January 30, 2007, Appellant filed a response ("Response under 37 C.F.R. § 1.116") to the Final Office Action dated October 30, 2006 ("Final Action"). In this response, Appellant argued that claims 3, 5 to 7, 9, 10 and 12 to 20 satisfy the utility requirements of 35 U.S.C. §§ 101 and the enablement requirement of 35 U.S.C. § 112, first paragraph. The Examiner issued an Advisory Action, dated February 16, 2007 ("Advisory Action") in which she indicated that the response was entered but it did not place the application in condition for allowance. The Examiner indicated, however, that the rejection of claims 12 to 15 and 17 to 19 under 35 U.S.C. § 112, first paragraph (written description), of claims 3, 5, 6, 7, 9 and 10 to 19 under 35 U.S.C. § 102(b) over Tanksley *et al.* (U.S. Pat. No. 5,648,599), and claims 10 to 20 under 35 U.S.C. § 102(b) over Stratagene Catalog (1997, p. 95) are withdrawn. Advisory Action at page 2.

#### **5. Summary of Claimed Subject Matter**

Independent Claim 3: The subject matter of independent claim 3 is directed to a transformed plant cell having a nucleic acid molecule which comprises: (A) an exogenous promoter region which functions in the cell to cause the production of a mRNA molecule, wherein the promoter nucleic acid molecule comprises SEQ ID NO: 1 or the complement thereof; which is linked to (B) a structural nucleic acid molecule encoding a protein or peptide; which is linked to (C) a 3' non-translated sequence that functions in the cell to cause termination of transcription and addition of polyadenylated ribonucleotides to a 3' end of the mRNA molecule. *Specification* at page 16, line 12 to page 23, line 23; page 71, line 10 to page 80, line 19; and original claim 3.

Independent Claim 7: The subject matter of independent claim 7 is directed to a transformed plant having a nucleic acid molecule which comprises: (A) an exogenous promoter region which functions in a plant cell to cause the production of a mRNA molecule, wherein the promoter nucleic acid molecule comprises SEQ ID NO: 1, or the complement thereof; which is linked to (B) a structural nucleic acid molecule encoding a protein or peptide; which is linked to (C) a 3' non-translated sequence that functions in a plant cell to cause termination of transcription and addition of polyadenylated ribonucleotides to a 3' end of the mRNA molecule. *Specification* at page 16, line 12 to page 23, line 23; page 71, line 10 to page 80, line 19; and original claim 7.

Independent Claim 12: The subject matter of independent claim 12 is directed to a substantially purified nucleic acid molecule, wherein the nucleic acid molecule comprises a nucleic acid sequence having between 100% and 70% identity with a nucleic acid sequence of SEQ ID NO: 1 or the complement thereof. *Specification* at page 25, lines 3 to 9.

A copy of the claims on appeal is attached hereto in the Claims Appendix.

## **6. Grounds of Rejection to be Reviewed on Appeal**

The grounds of rejection to be reviewed in this Appeal are that pending claims 3, 5 to 7, 9, 10 and 12 to 20 stand rejected under 35 U.S.C. §§ 101 because the claimed invention is allegedly not supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility, and that claims 3, 5 to 7, 9, 10 and 12 to 20 stand rejected under 35 U.S.C. § 112, first paragraph, because, allegedly, since the claimed invention lacks utility, one skilled in the art would not know how to use the claimed invention.

## **7. Argument**

### **A. Summary of Appellant's Position**

Appellant has provided a specific, substantial, and credible utility for a nucleic acid molecule comprising a nucleic acid sequence that exhibits between 100% and 70% sequence identity to the nucleic acid sequence of SEQ ID NO: 1 and complement thereof, as well as plants and plant cells that have been transformed using SEQ ID NO: 1. Appellant has further provided a statistically significant correlation between the nucleic acid sequence of SEQ ID NO: 1 and a known sequence. In addition to the other utilities disclosed in the specification, this correlation between SEQ ID NO: 1 and the known sequence is specific and established by a well-known technique. In setting forth a reasonable correlation between the nucleic acid sequence of SEQ ID NO: 1 and the known sequence, Appellant has demonstrated that the claimed sequence, the transformed plant cell comprising the sequence, and the transformed plant comprising the sequence have patentable utility. In other words, Appellant has satisfied the utility requirements of 35 U.S.C. §§ 101. Further, Appellant has also satisfied the requirements of 35 U.S.C. § 112, first paragraph.

### **B. The Claimed Invention Has Utility under 35 U.S.C. § 101**

The Examiner rejected claims 3, 5 to 7, 9, 10 and 12 to 20 under 35 U.S.C. § 101, because the claimed invention allegedly "lacks patentable utility due to its not being supported by a specific, substantial, and credible utility or, in the alternative, a well-established utility." Final Action at page 5.

The Examiner acknowledges that the specification as filed discloses several uses for the claimed nucleic acid molecules, constructs and plants. Final Action at page 6-8. Further,

Appellant has confirmed a specific utility of SEQ ID NO: 1 by conducting a BLASTN analysis. The specification as filed discloses that a BLASTN analysis is a well-known and conventional technique that can be used to obtain information on nucleic acid sequences. *Specification* at page 4, line 20 to page 5, line 17. The results of a BLASTN analysis of SEQ ID NO: 1 show that SEQ ID NO: 1 has 95 percent identity to a sequence obtained from *Glycine max* (soybean). *See*, Response under 37 C.F.R. § 1.116 at pages 2 to 3. Appellant respectfully submits that the results of the BLASTN analysis demonstrate that SEQ ID NO: 1 has utilities specific to it and not generally applicable to any nucleic acid.

In *In re Fisher*, the Federal Circuit reiterated that the “basic *quid pro quo* contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with *substantial utility*.” *In re Fisher*, 421 F.3d 1365, 1371 (Fed. Cir. 2005) (citing *Brenner v. Manson*, 383 U.S. at 534-35, 1966) (emphasis in original). The Court noted that since *Brenner* “our predecessor court, the Court of Customs and Patent Appeals, and this court have required a claimed invention to have a specific and substantial utility to satisfy § 101.” *Id.* Furthermore, an invention need only provide one identifiable benefit to satisfy 35 U.S.C. § 101. *See Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 958 (Fed. Cir. 1983) (“when a properly claimed invention meets at least one stated objective, utility under section 101 is clearly shown”).

Although the Supreme Court has not defined the meaning of the terms “specific” and “substantial”, the Federal Circuit has identified a framework for the kind of disclosure an application could contain to establish a specific and substantial utility. *In re Fisher*, 421 F.3d at 1371. First, the Court indicated that to provide a substantial utility, the specification should

disclose a utility such that “one skilled in the art can use a claimed discovery in a manner which provides some *immediate benefit to the public*.” *Id.* (emphasis in original). Second, a specific utility can be disclosed by discussing “a use which is not so vague as to be meaningless,” that is that the claimed invention “can be used to provide a well-defined and particular benefit to the public.” *Id.*

Appellant respectfully submits that they have satisfied the utility test set forth in *In re Fisher*, *i.e.*, that the utilities of SEQ ID NO: 1 are specific, substantial, and well-established, and provide a well-defined and particular benefit to the public. Appellant also respectfully submits that they have satisfied the utility test set forth in *In re Fisher* with respect to the transformed plant cell comprising SEQ ID NO: 1 and the transformed plant comprising SEQ ID NO: 1. By showing that the claimed SEQ ID NO: 1 is reasonably correlated with a known sequence, the utility of SEQ ID NO: 1 is specific, substantial, and credible.

The utility of SEQ ID NO: 1 is *specific* because it is specific to SEQ ID NO: 1 and not generally to any nucleic acid sequence. In other words, SEQ ID NO: 1, and not just any general nucleic acid sequence, shares 95 percent identity to a sequence obtained from *Glycine max* and this sequence was generated from soybean root hair tissue treated with *Bradyrhizobium japonicum* for 24 hours. Response under 37 C.F.R. § 1.116 at page 3. This utility is *substantial* and *credible* because SEQ ID NO: 1 can be used to isolate genes, map genes, and determine gene function associated with nitrogen fixation because it is well known to one of ordinary skill in the art that *B. japonicum* is a gram negative, nitrogen-fixing bacterium belonging to the Rhizobiaceae family. *B. japonicum* and *Glycine max* have a symbiotic relationship and *B. japonicum* helps *Glycine max* fix nitrogen, *i.e.*, convert nitrogen gas into a form readily utilized

by the plant. The result of this symbiosis is a dramatic increase in plant production without the need for adding external fertilizer. *Id.*

The Office must accept a stated utility by an applicant unless the Office has evidence or sound scientific reasoning to rebut the applicant's assertion. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). "More specifically, when a patent application claiming a nucleic acid asserts a specific, substantial, and credible utility, and bases the assertion upon homology to existing nucleic acids or proteins having an accepted utility, the asserted utility must be accepted by the examiner unless the Office has sufficient evidence or sound scientific reasoning to rebut such an assertion." Federal Register 66(4):1096, Utility Guidelines (2001). Furthermore, "a 'rigorous correlation' need not be shown in order to establish practical utility; 'reasonable correlation' is sufficient." *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1565 (Fed. Cir. 1996). "An Applicant can establish this reasonable correlation by relying on statistically relevant data documenting the activity of the compound or composition, arguments or reasoning, documentary evidence, or any combination thereof." M.P.E.P. § 2107.03, Rev. 5 at page 2100-34. The BLASTN analysis provides such a reasonable correlation through sequence identity. A 95 percent identity to a sequence obtained from *Glycine max*, which was generated from soybean root hair tissue treated with *B. japonicum* for 24 hours, is a reasonable correlation.

The Office "has the initial burden of challenging a presumptively correct assertion of utility in the disclosure." *In re Brana*, 51 F.3d 1560, 1567 (Fed. Cir. 1995). The utilities asserted in the specification must be accepted as factually sound unless the Office cites information that undermines the credibility of the assertion. *Id.* The Examiner "must do more than merely question operability – [she] must set forth factual reasons which would lead one skilled in the art



to question the objective truth of the statement of operability.” *In re Gaubert*, 524 F.2d 1222, 1224-25 (C.C.P.A. 1975) (emphasis in original); M.P.E.P. § 706.03(a)(1) (“Office personnel are reminded that they must treat as true a statement of fact made by an applicant in relation to an asserted utility, unless countervailing evidence can be provided...”). Here, the Examiner has not met this burden.

The Examiner’s position appears to be that isolation and mapping of genes and determining gene function associated with nitrogen fixation are not specific or substantial utilities apparently because no specific utility for SEQ ID NO: 1 has been shown. *See*, Advisory Action at page 2 and Final Action at pages 6 to 7. Further, the Examiner states that Appellant cannot use information regarding nitrogen fixation as an indication of utility because this utility was “not asserted in the specification, and therefore cannot be considered an asserted specific, substantial and credible utility at the time of filing.” Advisory Action at page 2.

Appellant respectfully submits that the Examiner’s analysis is legally incorrect. The specification as filed clearly disclosed that isolation and mapping of genes and determining gene function associated with the nucleic acid molecules of the invention is are stated utilities of the invention. *See, e.g., Specification* at page 11, line 10 to page 12, line 18. Nitrogen fixation is merely an example of such a utility. As the M.P.E.P. makes clear, “(t)he specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public.” M.P.E.P. § 2164.05(a). *See also, In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann*

*Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (Fed. Cir. 1984).

Furthermore, it is well-established patent jurisprudence that Appellant need not teach “conventional and well-known genetic engineering techniques.” *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1345 (Fed. Cir. 2000). The specification as filed not only discloses that examples of utilities of the claimed invention are to isolate genes, map genes, and determining gene function associated with the disclosed nucleic acid molecules but also discloses how one of ordinary skill in the art can ascertain utility of the same nucleic molecules by conducting BLAST searches.

In conclusion, Appellant respectfully submits that SEQ ID NO: 1 has specific, substantial, and credible utility, or a well-established utility, because it has a reasonable correlation with a sequence obtained from *Glycine max* (which was generated from soybean root hair tissue treated with *B. japonicum* for 24 hours). SEQ ID NO: 1 can be used in a manner that provides some immediate benefit to the public, for example in transformed plant cells or plants comprising SEQ ID NO: 1. In other words, the claimed invention meets the utility test set forth in *In re Fisher* and the Appellants respectfully request that the Board reverse the rejection of claims 8 to 12 under 35 U.S.C. § 101.

**C. The Claimed Invention Satisfies the Requirements of 35 U.S.C. § 112, first paragraph**

The Examiner rejected claims 3, 5 to 7, 9, 10 and 12 to 20 under 35 U.S.C. § 112, first paragraph, allegedly because, according to the Examiner, “since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility”, one skilled in the art “would not know how to use the claimed invention.” Final Action at page 13.

Appellant respectfully submits that this rejection has been overcome by the arguments set forth above with respect to the rejection under 35 U.S.C. § 101. In other words, Appellant respectfully submits that the claimed invention has specific, substantial, and credible utility, or a well-established utility, and requests that the Board reverse the rejection of claims 3, 5 to 7, 9, 10 and 12 to 20 under 35 U.S.C. § 112, first paragraph.

**D. The Claimed Invention Satisfies the Enablement Requirement of 35 U.S.C. § 112, first paragraph**

The Examiner rejected claims 3, 5 to 7, 9, 10 and 12 to 20 under 35 U.S.C. § 112, first paragraph, as allegedly “failing to comply with the enablement requirement.” Final Action at page 14 and Advisory Action at page 2.

Appellant respectfully submits that the specification as filed fully enables claims 3, 5 to 7, 9, 10 and 12 to 20 because performing routine and well-known steps, such as sequence alignment protocols, construct preparation, and gene expression analysis, cannot create undue experimentation even if the steps are laborious. *In re Angstadt*, 537 F.2d 498, 504 (C.C.P.A. 1976). The Examiner’s position is that the present application differs from *In re Angstadt* because “not a single working example of a construct which comprises SEQ ID NO: 1 within a promoter that functions as set forth in the claims or any other enabled utility for SEQ ID NO: 1 is provided.” Final Action at page 29. However, the presence or absence of an example cannot be the basis for an enablement rejection under 35 U.S.C. § 112, first paragraph. *See*, M.P.E.P. § 2164.02.

The Examiner states that the presence or absence of a working example is a factor in cases involving unpredictable or undeveloped art. Appellant does not disagree that if this were an unpredictable or undeveloped art, the presence or absence of a working example would be a

factor. However, this art is neither unpredictable nor undeveloped and the Examiner's position is incorrect. For example, the Examiner states that "(t)here is no way to predict how one could change hundreds of nucleotides within SEQ ID NO: 1 and still arrive at a molecule that has any similar function to SEQ ID NO: 1, whether it be a partial promoter function or enhancer function or encoding structural gene function." Final Action at page 30.

First, SEQ ID NO: 1 is 394 nucleotides long and a molecule that has 70% identity to SEQ ID NO: 1 (the lowest limit claimed) would involved *at most* a change of 118 nucleotides – not hundreds as the Examiner alleges. Second, this number vastly over-counts the number of possible changes because, as the specification makes clear (and as one of ordinary skill in the art is aware), conservative nucleic acid substitutions generally retain functionality while non-conservative substitutions generally do not. *See, for example*, Specification at pages 26 and 27. Third, one of ordinary skill in the art would know, or be able to predict, how each of the possible 118 nucleotide changes would affect SEQ ID NO: 1. In other words, the Examiner's statement that "there was no way to predict which changes could be made to the sequence without abolishing function" is incorrect. Final Action at page 30. If one of ordinary skill in the art can reasonably predict, without undue experimentation, what the effects of changes would be, *i.e.*, which would be successes and which would be failures, the claim is enabled through its entire scope. *See, for example*, *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577 (Fed. Cir. 1984).

The Examiner also states that "even though the change would involve at most 118 nucleotides this is still a large number of substitutions given the potential for the effect of the substitution [*sic*] on the function of the molecule. While conservative substitutions generally do

not effect [sic] nucleic acid function, they sometimes to [sic] by effecting [sic] transcript stability, for example, and when this might occur is highly unpredictable.” Advisory Action at page 2. Appellant reiterates that the issue is not whether 118 substitutions are large or not, but rather whether one of ordinary skill in the art can reasonably predict, without undue experimentation, what the effects of those substitutions would be. If so, the claim is enabled through its entire scope. Further, the Examiner has not offered any scientific evidence to support her contention that conservative substitutions affect transcript stability.

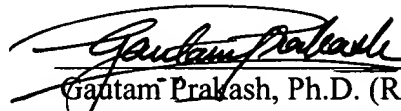
In conclusion Appellant respectfully submits the specification as filed fully enables claims 3, 5 to 7, 9, 10 and 12 to 20 and therefore requests that the Board reverse the rejection of these claims under 35 U.S.C. § 112, first paragraph.

**CONCLUSION**

In view of the foregoing, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the pending rejections and that the subject application be allowed forthwith.

Respectfully submitted,

Date: May 25, 2007

  
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**CLAIMS APPENDIX**

Claim 3. A transformed plant cell having a nucleic acid molecule which comprises:

- (A) an exogenous promoter region which functions in said cell to cause the production of a mRNA molecule, wherein said promoter nucleic acid molecule comprises SEQ ID NO: 1 or the complement thereof; which is linked to
- (B) a structural nucleic acid molecule encoding a protein or peptide; which is linked to
- (C) a 3' non-translated sequence that functions in said cell to cause termination of transcription and addition of polyadenylated ribonucleotides to a 3' end of said mRNA molecule.

Claim 5. A transformed plant cell according to claim 3, wherein said plant cell is a dicot plant cell.

Claim 6. A transformed plant cell according to claim 3, wherein said plant cell is a monocot plant cell.

Claim 7. A transformed plant having a nucleic acid molecule which comprises:

- (A) an exogenous promoter region which functions in a plant cell to cause the production of a mRNA molecule, wherein said promoter nucleic acid molecule comprises SEQ ID NO: 1, or the complement thereof; which is linked to
- (B) a structural nucleic acid molecule encoding a protein or peptide; which is linked to
- (C) a 3' non-translated sequence that functions in a plant cell to cause termination of transcription and addition of polyadenylated ribonucleotides to a 3' end of said mRNA molecule.

Claim 9. The transformed plant according to claim 7, wherein said plant is a dicot.

Claim 10. The transformed plant according to claim 7, wherein said plant is a monocot.

Claim 12. A substantially purified nucleic acid molecule, wherein said nucleic acid molecule comprises a nucleic acid sequence having between 100% and 70% identity with a nucleic acid sequence of SEQ ID NO: 1 or the complement thereof.

Claim 13. A substantially purified nucleic acid molecule according to claim 12, wherein said nucleic acid molecule comprises a nucleic acid sequence having between 100% and 80% identity with a nucleic acid sequence of SEQ ID NO: 1 or the complement thereof.

Claim 14. A substantially purified nucleic acid molecule according to claim 13, wherein said nucleic acid molecule comprises a nucleic acid sequence having between 100% and 90% identity with a nucleic acid sequence of SEQ ID NO: 1 or the complement thereof.

Claim 15. A substantially purified nucleic acid molecule according to claim 14, wherein said nucleic acid molecule comprises a nucleic acid sequence having between 100% and 95% identity with a nucleic acid sequence of SEQ ID NO: 1 or the complement thereof.

Claim 16. A substantially purified nucleic acid molecule according to claim 15, wherein said nucleic acid molecule comprises a nucleic acid sequence of SEQ ID NO: 1 or the complement thereof.

Claim 17. The substantially purified nucleic acid molecule according to claim 12, wherein said nucleic acid molecule further comprises a region having a single nucleotide polymorphism.



Claim 18. The substantially purified nucleic acid molecule according to claim 12, wherein said nucleic acid molecule further comprises a promoter or partial promoter region.

Claim 19. The substantially purified nucleic acid molecule according to claim 18, wherein said promoter region comprises a CAAT cis element and a TATA cis element and an additional cis element.

Claim 20. The substantially purified nucleic acid molecule according to claim 16, wherein said nucleic acid molecule consists of a nucleic acid sequence of SEQ ID NO: 1 or the complement thereof.

**EVIDENCE APPENDIX**

None



**RELATED PROCEEDINGS APPENDIX**

1. *Ex parte Fisher*, 72 U.S.P.Q.2d 1020 (Bd. Pat. App. Int. 2004);
2. *In re Fisher*, 421 F.3d 1365 (Fed. Cir. 2005);
3. BPAI Appeal No. 2004-1772;
4. Appeal Brief filed in U.S. Patent Application Serial No. 09/684,016;
5. Appeal Brief filed in U.S. Patent Application Serial No. 10/361,942;
6. Appeal Brief filed in U.S. Patent Application Serial No. 09/199,129;
7. Appeal Brief filed in U.S. Patent Application Serial No. 09/920,953;
8. Appeal Brief filed in U.S. Patent Application Serial No. 09/663,423;
9. Appeal Brief filed in U.S. Patent Application Serial No. 09/237,183;
10. Appeal Brief filed in U.S. Patent Application Serial No. 09/692,257;
11. Appeal Brief filed in U.S. Patent Application Serial No. 10/437,963; and
12. Appeal Brief filed in U.S. Patent Application Serial No. 09/531,113.

Ex parte Fisher

U.S. Patent and Trademark Office Board of Patent  
Appeals and Interferences

Appeal No. 2002-2046

Decided April 1, 2004

**PATENTS**

**[1] Patentability/Validity – Utility (§ 115.10)**

Invention must have "substantial" utility in order to be "useful" within meaning of 35 U.S.C. § 101, since, if Section 101's requirement is given its broadest reach, then little or nothing of chemical nature would be found to lack utility; thus, invention must provide specific benefit in its currently available form, and vague, general disclosures or arguments that invention is "useful in research," or statements that invention is capable of being used for particular purpose, would not satisfy Section 101.

**[2] Patentability/Validity – Utility (§ 115.10)**

Disclosed use of claimed nucleic acid molecules encoding maize protein in identifying and detecting polymorphisms in population of maize plants does not provide "substantial" degree of utility required for invention to be "useful" within meaning of 35 U.S.C. § 101, since specification does not explain why claimed nucleotide molecules would in fact be useful in detecting polymorphisms, and since, without further information regarding gene represented by molecules, detection of presence or absence of polymorphism provides only barest information concerning genetic heritage.

**[3] Patentability/Validity – Utility (§ 115.10)**

Disclosed use of claimed nucleic acid molecules encoding maize protein to isolate nucleic acid molecules of other plants and organisms does not provide "substantial" degree of utility required for invention to be "useful" within meaning of 35 U.S.C. § 101, since specification does not attribute any property, in terms of plant trait or phenotype, to any of disclosed nucleotide molecules, and absent such information, using claimed molecules to isolate other molecules does not represent substantial utility; applicants' assertion that claimed nucleic acid molecules may be useful in searching for certain promoters does not supply required utility, since specification does not provide any expectation of successfully using any of claimed molecules to isolate such promoters, and since there is no evidence that claimed molecules are tissue or cell-type specific, or developmentally or environmentally regulated.

**[4] Patentability/Validity – Utility (§ 115.10)**

Invention can have utility shared by other compounds or compositions, but not every utility will satisfy requirements of 35 U.S.C. § 101, even if utility is shared by class of inventions; thus, although utility need not be unique to claimed invention, it must nevertheless be specific, and in currently available form, in order to satisfy Section 101.

**[5] Patentability/Validity – Utility (§ 115.10)**

Assertion that claimed nucleic acid molecules encoding maize protein can be introduced into plant or plant cell, which can then be used to screen for compounds such as herbicides, does not provide "substantial" degree of utility required for invention to be "useful" within meaning of 35 U.S.C. § 101, since invention claims otherwise uncharacterized nucleic acid molecule, not "cell-based assay," and since specification does not indicate that asserted screening method is feasible if uncharacterized nucleic acid is used.

**[6] Patentability/Validity – Utility (§ 115.10)**

Disclosed use of claimed nucleic acid molecules encoding maize protein as components of assays for monitoring gene expression does not provide "substantial" degree of utility required for invention to be "useful" within meaning of 35 U.S.C. § 101, since specification provides no guidance that would allow person skilled in art to use data relating to expression of gene in any practical way; claim that those skilled in art could experiment with claimed nucleic acids and figure out for themselves what results might mean does not provide "specific benefit in currently available form," and although each nucleic acid used in gene expression assay contributes to data generated by assay as whole, fact that assay itself may have patentable utility does not mean that each tiny component of assay also has patentable utility.

**[7] Patentability/Validity -- Specification -- Written description (§ 115.1103)**

Application claiming five nucleic acid molecules encoding maize protein was improperly rejected for failure to satisfy written description requirement of 35 U.S.C. § 112, since application provides nucleotide sequences for five molecules, and claim's use of "comprising" allows for addition of nucleotides or other molecules at either end of nucleotide sequences without permitting internal alterations of sequences, and since fact that claimed molecules may have other molecules attached at their ends does not diminish adequate written description of molecules having sequences set forth in application.

\*1021 Patent application of Dane K. Fisher and Raghunath V. Lalgudi, serial no. 09/619,643 (nucleic

acid molecule encoding maize protein or fragment thereof). Applicants appeal from examiner's final rejection of sole claim pending in application. Affirmed in part and reversed in part.

[Editor's Note: The Board of Patent Appeals and Interferences states that this opinion was not written for publication, and is not binding precedent of the board.]

Lawrence M. Lavin Jr., Monsanto Co., St. Louis, Mo., for applicants.

Before William F. Smith, Adams, and Grimes, administrative patent judges.

Adams, J.

#### DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claim 1, the only claim pending in the application, reproduced below:

1.A substantially purified nucleic acid molecule that encodes a maize protein or fragment thereof comprising a nucleic acid sequence selected from the group consisting of SEQ ID NO: 1 through SEQ ID NO:5.

The examiner does not rely on a reference.

#### GROUND OF REJECTION

Claim 1 stands rejected under 35 U.S.C. § 101 as lacking utility and § 112, first paragraph, for lack of enablement based on the finding of lack of utility. Claim 1 also stands rejected under 35 U.S.C. § 112, first paragraph, as the specification fails to provide an adequate written description of the claimed invention. We affirm the utility and enablement rejections. We reverse the written description rejection.

#### BACKGROUND

The subject matter of the present appeal is directed to expressed sequence tags (ESTs). See Specification, page 15, lines 9-10. ESTs "are short sequences of randomly selected clones from a cDNA (or complementary DNA) library which are representative of the cDNA inserts of these randomly selected clones." Specification, page 1.

As set forth at page 9, lines 2-4, of appellants' specification "[t]he present invention provides a substantially purified nucleic acid molecule that encodes a maize protein or fragment thereof comprising a nucleic acid sequence selected from the

group consisting of \*1022 SEQ ID NO: 1 through SEQ ID NO: 32236." Of these 32,236 nucleic acid sequences, the originally filed claims were directed to SEQ ID NO: 1 through SEQ ID NO: 4,013. On January 26, 2001 (Paper No. 4), the examiner entered a Restriction requirement into the record, requiring, *inter alia*, appellants "to elect up to 5 nucleic acid sequences" for consideration on the merits. Paper No. 4, page 3. In response, appellants elected SEQ ID NO:1 through SEQ ID NO:5. The ESTs set forth in SEQ ID NO: 1 through SEQ ID NO: 5 are disclosed to be obtained from cDNA library LIB3115 "generated from maize (RX601, Asgrow Seed Company, Des Moines, Iowa U.S.A.) pooled leaf tissue. ..." Specification, pages 79-80, Example 1.

The specification sets forth a number of utilities for the nucleic acid molecules of SEQ ID NO: 1 through SEQ ID NO: 5 which are summarized by the examiner (Answer, bridging paragraph, pages 5-6) as follows:

The specification teaches that the nucleic acids may be used to produce a plant containing reduced levels of a protein (pg. 11), determining an association between a polymorphism and a plant trait (pg. 11), isolating a genetic region or nucleic acid (pg. 11), determining a level or pattern in a plant cell of a protein in a plant (pg. 11), determining a mutation in a plant whose presence is predictive of a mutation affecting a level or pattern of a protein (pg. 13), as molecular tags to isolate genetic regions, isolate genes, map genes, and determine gene function (pg. 14), and identifying tissues (pg. 14). The specification states that the nucleic acid ESTs of the present invention can enable the acquisition of molecular markers, which can be used in breeding schemes, genetic and molecular mapping and cloning of agronomically significant genes (pg. 31).

In the examiner's opinion "[t]hese are non-specific uses that are applicable to nucleic acids in general and not particular or specific to the nucleic acids being claimed." Answer, page 6. For example, the examiner finds (Answer, page 10), "determining whether the claimed nucleic acids have or do not have a polymorphism would require determining whether there was a polymorphism within such a sequence and then determining how to use this information in a patentably meaningful way." [FN1]

In presenting their case on appeal, appellants focus on use of the claimed nucleic acid molecules to identify the presence or absence of a polymorphism, and their use as probes or as a source for primers. See e.g., Brief, pages 6- 12. According to appellants

(Brief, page 3), "they have disclosed nucleic acid molecules which, in their current form, provide at least one specific benefit to the public, for example the ability to identify the presence or absence of a polymorphism in a population of maize plants." Furthermore, appellants assert (Brief, page 8), "[t]he specification discloses that the claimed nucleic acid molecules can be used to isolate nucleic acid molecules of other plants and organisms. ..."

#### CLAIM CONSTRUCTION

As set forth above, claim 1 on appeal is drawn to a substantially purified nucleic acid molecule that encodes a maize protein or fragment thereof comprising a nucleic acid sequence selected from the group consisting of SEQ ID NO: 1 through SEQ ID NO:5. According to appellants' specification (page 15, lines 19-25), the term "substantially purified"

refers to a molecule separated from substantially all other molecules normally associated with it in its native state. More preferably a substantially purified molecule is the predominant species present in a preparation. A substantially purified molecule may be greater than 60% free, preferably 75% free, more preferably 90% free, and most preferably 95% free from the other molecules (exclusive of solvent) present in the natural mixture. The term "substantially purified" is not intended to encompass molecules present in their native state.

As we understand the claimed invention the use of the transitional term "comprising" does not allow for internal alterations (e.g. insertions or deletions) of the nucleotide sequences set forth in SEQ ID NO: 1 through SEQ ID NO: 5, but instead only allows for the addition of nucleotides or other molecules at either end of the nucleotide sequences set forth in SEQ \*1023 ID NO: 1 through SEQ ID NO: 5. [FN2] In this regard, we recognize, as does the examiner (Answer, page 14), the claim as written encompasses, *inter alia*, genes, full open reading frames, fusion constructs, and cDNAs.

Accordingly, for the purposes of our review, we interpret the claimed invention as drawn to a nucleic acid molecule, separated from substantially all other molecules normally associated with it in its native state, selected from the group consisting of the nucleic acid molecule defined by the 429 nucleotide sequence set forth in SEQ ID NO: 1, the 413 nucleotide sequence set forth in SEQ ID NO: 2, the 365 nucleotide sequence set forth in SEQ ID NO: 3, the 414 nucleotide sequence set forth in SEQ ID NO: 4, and the 333 nucleotide sequence set forth in SEQ ID NO: 5, with or without any preceding or trailing

nucleotides, or other molecules.

#### DISCUSSION

##### Utility

The starting point for determining whether a nucleic acid molecule selected from the group consisting of SEQ ID NO: 1 through SEQ ID NO: 5 possesses utility under 35 U.S.C. § 101 is Brenner v. Manson, 383 U.S. 519, 148 USPO 689 (1966). As set forth in Brenner, at 534-35, 148 USPO at 695 [FN3],

the basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility. Unless and until [an invention] is refined and developed to this point--where specific benefit exists in currently available form--there is insufficient justification for permitting an applicant to engross what may prove to be a broad field.

In considering the issues presented in this appeal, special attention must be paid to the Brenner court's statement that a patent should issue only when an invention possesses "substantial utility," *i.e.*, "where a specific benefit exists in currently available form." Whether a claimed invention is useful under 35 U.S.C. § 101 is a question of fact. Cross v. Iizuka, 753 F.2d 1040, 1044 n.7, 224 USPO 739, 742 n.7 (Fed. Cir. 1985).

At issue in Brenner was a claim to "a chemical process which yields an already known product whose utility--other than as a possible object of scientific inquiry--ha[d] not yet been evidenced." Id. at 529, 148 USPO at 693. The Patent Office had rejected the claimed process for lack of utility, on the basis that the product produced by the claimed process had not been shown to be useful. See id. at 521-22, 148 USPO at 690. On appeal, the Court of Customs and Patent Appeals reversed, on the basis that "where a claimed process produces a known product it is not necessary to show utility for the product." Id. at 522, 148 USPO at 691.

The Brenner Court noted that although § 101 requires that an invention be "useful," that "simple, everyday word can be pregnant with ambiguity when applied to the facts of life." Id. at 529, 148 USPO at 693. Thus,

[i]t is not remarkable that differences arise as to how the test of usefulness is to be applied to chemical processes. Even if we knew precisely what Congress meant in 1790 when it devised the "new and useful"

phraseology and in subsequent re-enactments of the test, we should have difficulty in applying it in the context of contemporary chemistry, where research is as comprehensive as man's grasp and where little or nothing is wholly beyond the pale of "utility"--if that word is given its broadest reach.

Id. at 530, 148 USPO at 694. [FN4]

The Court, finding "no specific assistance in the legislative materials underlying § 101," based its analysis on "the general intent of Congress, the purposes of the patent system, and the implications of a decision one way or the other." Id. at 532, 148 USPO at 695. The Court concluded that "[t]he basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility. Unless and until \*1024 a process is refined and developed to this point--where specific benefit exists in currently available form--there is insufficient justification for permitting an applicant to engross what may prove to be a broad field." Id. at 534-35, 148 USPO at 695.

The Court considered and rejected the applicant's argument that attenuating the requirement of utility "would encourage inventors of new processes to publicize the event for the benefit of the entire scientific community, thus widening the search for uses and increasing the fund of scientific knowledge." The Court noted that, while there is value to encouraging disclosure, "a more compelling consideration is that a process patent in the chemical field, which has not been developed and pointed to the degree of specific utility, creates a monopoly of knowledge which should be granted only if clearly commanded by the statute. Until the process claim has been reduced to production of a product shown to be useful, the metes and bounds of that monopoly are not capable of precise delineation. It may engross a vast, unknown, and perhaps unknowable area. Such a patent may confer power to block off whole areas of scientific development." Id. at 534, 148 USPO at 695.

The Court took pains to note that it did not "mean to disparage the importance of contributions to the fund of scientific information short of the invention of something 'useful,'" and that it was not "blind to the prospect that what now seems without 'use' may tomorrow command the grateful attention of the public." Id. at 535-36, 148 USPO at 696. Those considerations did not sway the Court, however, because "a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion." Id.

Subsequent decisions of the CCPA and the Court of Appeals for the Federal Circuit have added further layers of judicial gloss to the meaning of § 101's utility requirement. The first opinion of the CCPA applying *Brenner* was *In re Kirk*, 376 F.2d 936, 153 USPO 48 (CCPA 1967). The invention claimed in *Kirk* was a set of steroid derivatives said to have valuable biological properties and to be of value "in the furtherance of steroidal research and in the application of steroidal materials to veterinary or medical practice." Id. at 938, 153 USPO at 50. The claims had been rejected for lack of utility. In response, the applicants submitted an affidavit which purportedly "show[ed] that one skilled in the art would be able to determine the biological uses of the claimed compounds by routine tests." Id. at 939, 153 USPO at 51.

The court held that "nebulous expressions [like] 'biological activity' or 'biological properties'" did not adequately convey how to use the claimed compounds. Id. at 941, 153 USPO at 52. Nor did the applicants' affidavit help their case: "the sum and substance of the affidavit appear[ed] to be that one of ordinary skill in the art would know 'how to use' the compounds to find out in the first instance whether the compounds are--or are not--in fact useful or possess useful properties, and to ascertain what those properties are." Id. at 942, 153 USPO at 53.

The *Kirk* court held that an earlier CCPA decision, holding that a chemical compound meets the requirements of § 101 if it is useful to chemists doing research on steroids, had effectively been overruled by *Brenner*. "There can be no doubt that the insubstantial, superficial nature of vague, general disclosures or arguments of 'useful in research' or 'useful as building blocks of value to the researcher' was recognized, and clearly rejected, by the Supreme Court" in *Brenner*. See *Kirk*, 376 F.2d at 945, 153 USPO at 55.

More recently, in *In re Ziegler*, 992 F.2d 1197, 26 USPO2d 1600 (Fed. Cir. 1993), the Federal Circuit considered the degree of specificity required to show utility for a claim to polypropylene. The U.S. application on appeal in *Ziegler* claimed priority to a German application filed in 1954. "In the German application, Ziegler disclosed only that solid granules of polypropylene could be pressed into a flexible film with a characteristic infrared spectrum and that the polypropylene was 'plastic-like.'" Id. at 1203, 26 USPO2d at 1605. "Ziegler did not assert any practical use for the polypropylene or its film, and Ziegler did not disclose any characteristics of the polypropylene

or its film that demonstrated its utility." *Id.* The court held that the German application did not satisfy the requirements of § 101 and therefore could not be relied on to overcome a rejection based on an intervening reference. *Id.* "[At] best, Ziegler was on the way to discovering a practical utility for polypropylene at the time of the filing of the German application; but in that application Ziegler had not yet gotten there." *Id.*

On the other hand, the CCPA reversed a rejection for lack of utility in *In re Jolles*, 628 F.2d 1322, 206 USPO 885 (CCPA 1980). The applicant in *Jolles* claimed pharmaceutical compositions that were disclosed to be useful in treating acute myeloblastic leukemia. \*1025 See *id.* at 1323, 206 USPO at 886. The active ingredients in the compositions were closely related to daunorubicin and doxorubicin, both of which were "well recognized in the art as valuable for use in cancer chemotherapy." *Id.*, 206 USPO at 887. The applicant also submitted declaratory evidence showing that eight of the claimed compositions were effective in treating tumors in a mouse model, and one was effective in treating humans. See *id.* at 1323-24, 206 USPO at 887-88. The court noted that the data derived from the mouse model were "relevant to the treatment of humans and [were] not to be disregarded," *id.* at 1327, 206 USPO at 890, and held that the evidence was sufficient to support the asserted therapeutic utility. See *id.* at 1327-28, 206 USPO at 891.

The Federal Circuit held in *Cross v. Iizuka*, 753 F.2d 1040, 224 USPO 739 (Fed. Cir. 1985), that *in vivo* testing (as in *Jolles*) was not necessarily required to show utility in the pharmaceutical context. The *Cross* court stated that "[it] is axiomatic that an invention cannot be considered 'useful,' in the sense that a patent can be granted on it, unless substantial or practical utility for the invention has been discovered and disclosed where such utility would not be obvious." *Id.* at 1044, 224 USPO at 742 (citing *Brenner v. Manson*). The court "perceive[d] no insurmountable difficulty, under appropriate circumstances, in finding that the first link in the screening chain, *in vitro* testing, may establish a practical utility for the compound in question." *Id.* at 1051, 224 USPO at 748. Successful *in vitro* testing could provide an immediate benefit to the public, by "marshall[ing] resources and direct[ing] the expenditure of effort to further *in vivo* testing of the most potent compounds . . . , analogous to the benefit provided by the showing of an *in vivo* utility." *Id.* On the facts of that case -- successful *in vitro* testing supplemented by similar *in vitro* and *in vivo* activities of structurally similar compounds -- the court held

that *in vitro* activity was sufficient to meet the requirements of § 101. See *id.*

The Federal Circuit confirmed in *In re Brana*, 51 F.3d 1560, 34 USPO2d 1436 (Fed. Cir. 1995), that human testing is not necessary to establish utility for a method of treatment. The invention claimed in *Brana* was a group of compounds disclosed to have antitumor activity. See *id.* at 1562, 34 USPO2d at 1437-38. The specification disclosed that the claimed compounds had higher antitumor activity than related compounds known to have antitumor activity, and the applicants provided declaratory evidence of *in vivo* activity against tumors in a mouse model. See *id.*, 34 USPO2d at 1438. The court held that these data were sufficient to satisfy § 101; usefulness in patent law does not require that the invention be ready to be administered to humans. See *id.* at 1567, 34 USPO2d at 1442.

[1] Several lessons can be drawn from *Brenner* and its progeny. First, § 101's requirement that an invention be "useful" is not to be given its broadest reach, such that little or nothing of a chemical nature would be found to lack utility. See *Brenner*, 383 U.S. at 530, 148 USPO at 694. Thus, not every "use" that can be asserted will be sufficient to satisfy § 101. For example, the steroid compound at issue in *Brenner* was useful as a possible object of scientific inquiry, and the polypropylene claimed in *Ziegler* was useful for pressing into a flexible film, yet both lacked sufficient utility to satisfy § 101. See *Brenner*, 383 U.S. at 529, 148 USPO at 696; *Ziegler*, 992 F.2d at 1203, 26 USPO2d at 1605.

Rather than setting a *de minimis* standard, § 101 requires a utility that is "substantial", i.e., one that provides a specific benefit in currently available form. *Brenner*, 383 U.S. at 534-35, 148 USPO at 695. This standard has been found to be met by pharmaceutical compositions shown to be useful in mouse models and in humans for treating acute myeloblastic leukemia ( *Jolles*, 628 F.2d at 1327-28, 206 USPO at 891); by evidence showing successful *in vitro* testing supplemented by similar *in vitro* and *in vivo* activities of structurally similar compounds ( *Cross*, 753 F.2d at 1051, 224 USPO at 748); and by evidence showing *in vivo* antitumor activity in mice, combined with a disclosure that the claimed compounds had higher antitumor activity than a related compound known to have antitumor activity ( *Brana*, 51 F.3d at 1567, 34 USPO2d at 1442).

By contrast, *Brenner's* standard has been interpreted to mean that "vague, general disclosures or



arguments of 'useful in research' or 'useful as building blocks of value to the researcher' would not satisfy § 101. See *Kirk*, 376 F.2d at 945, 153 USPQ at 55 (interpreting *Brenner*). Likewise, a disclosure of a "plastic-like" polypropylene capable of being pressed into a flexible film was held to show that the applicant was "at best . . . on the way to discovering a practical utility for polypropylene at the time of the filing," but not yet there. *Ziegler*, at 1203, 26 USPQ2d at 1605.

With these principles in mind we turn to the issues at hand. Of the many utilities asserted \*1026 in the specification, two have received the most attention in the briefing in this appeal, i.e., identification and detection of polymorphisms and use as probes or as a source for primers. We shall focus on these asserted utilities first and then address the other arguments set forth in the briefing.

*a. Polymorphisms*

[2] This utility is discussed at pages 35-42 of the specification in terms of what polymorphisms are and how one would go about determining the existence of a polymorphism. The discussion in this portion of the specification, however, is not specific to the nucleotide molecules depicted in SEQ ID NO: 1 through SEQ ID NO: 5. To the contrary, according to appellants' specification (page 35, lines 25-26), "one or more of the [32,236] EST nucleic acid molecules (or a sub-fragment thereof) may be employed as a marker nucleic acid molecule to identify . . . polymorphism(s)." The specification does not explain why any of the 32,236 nucleotide molecules disclosed in the specification, or more specifically the five nucleotide molecules depicted in SEQ ID NO: 1 through SEQ ID NO: 5, would in fact be useful in detecting polymorphisms.

Rather, appellants argue (Brief, page 7), "the claimed nucleic acid molecules have utility even if the absence of a particular polymorphism is detected. Indeed, the absence of a polymorphism usually demonstrates that the two (or more) populations being compared share a common genetic heritage." In other words, appellants' position is that an EST by definition possesses patentable utility because it can be used by itself in determining whether populations share a common genetic heritage. While that may be a "utility," we do not find that it is a *substantial* utility.

Without knowing any further information in regard to the gene represented by an EST, as here, detection of the presence or absence of a polymorphism

provides the barest information in regard to genetic heritage. As the examiner explains (Answer, bridging paragraph, pages 10-11):

Polymorphisms are natural variations within sequences which themselves may not have any meaningful use. Therefore, determining whether the claimed nucleic acids [(or nucleic acids detected by the claimed nucleic acids)] have or do not have a polymorphism would require determining whether there was a polymorphism within such a sequence and then determining how to use this information in a patentably meaningful way. The [a]ppellant also argues, "many of these uses are directly analogous to a microscope". This argument has been reviewed but is not convincing because the microscope provides information to the scientist which is automatically useful. For example, the microscope may be used for identification and differentiation between gram-positive and gram-negative bacteria. The differentiation of bacteria facilitates in the administration of proper antibiotics. For example, if the microscope is used to determine whether Staph is present or whether Strep is present provides valuable information to the scientist and/or doctor for treating patients. The instant invention, however, provides no information to this extent. If the scientist determines that SEQ ID NO: 1 is present, the scientist does not know how to use this information. Thus, the identification of SEQ ID NO: 1 is not a substantial utility.

In contrast, at the other end of the "utility spectrum" would be information gleaned from detecting the presence or absence of a polymorphism when it is known what effect the gene from which the EST is derived has in the development and/or phenotype of the plant. Somewhere between having no knowledge (the present circumstances) and having complete knowledge of the gene and its role in the plant's development and/or phenotype lies the line between "utility" and "substantial utility." We need not draw the line or further define it in this case because the facts in this case represent the lowest end of the spectrum, i.e., an insubstantial use.

*b. Probes or source of primers*

[3] Appellants argue that the "specification discloses that the claimed nucleic acid molecules can be used to isolate nucleic acid molecules of other plants and organisms. . . ." Appeal Brief, page 8. While that may be true, it begs the question of what substantial use such nucleic acid molecules would have? Again, the present specification does not attribute any property in terms of plant trait, or phenotype to any of the nucleotide molecules set

forth in SEQ ID NO: 1 through SEQ ID NO: 5. In the absence of such information, using the claimed molecules to isolate other molecules, which themselves lack substantial utility, does not represent a substantial utility.

Appellants also assert that the claimed nucleic acid molecules may be used in a \*1027 "chromosome walk." Brief, pages 8-9. According to appellants (Brief, page 9),

The claimed nucleic acid molecules provide a particularly appropriate and demonstrably useful starting point for a walk to isolate a promoter that is active in leaves at the time of anthesis. Isolation of such a promoter would be desirable and particularly useful because it allows expression of proteins at that important developmental state, including proteins that provide disease resistance. Because the claimed nucleic acid molecules were isolated from leaves, they provide an appropriate starting point for isolating a promoter active in leaves. A random nucleic acid molecule does not provide an equally good starting point to isolate such a promoter.

As we understand this argument, the claimed ESTs may be useful in searching for promoters that are only active in leaves at the time of anthesis. The specification, however, fails to demonstrate that any of the nucleic acid molecules set forth in SEQ ID NO: 1 through SEQ ID NO: 5 would be useful in obtaining a successful result from such a search. As set forth at page 34, lines 14-19 of appellants' specification,

The [32,236] nucleic acid molecules of the present invention may be used to isolate promoters of tissue enhanced[,] tissue specific, cell-specific, cell-type, developmentally or environmentally regulated expression profiles. Isolation and functional analysis of the 5' flanking promoter sequences of these genes from genomic libraries, for example, using genomic screening methods and PCR techniques would result in the isolation of useful promoters and transcriptional regulatory elements.

The specification does not provide any expectation of successfully using any of the 32,236 nucleic acid molecules disclosed in the specification, or more specifically the five nucleic acid molecules depicted in SEQ ID NO: 1 through SEQ ID NO: 5, to isolate promoters of tissue enhanced, tissue specific, cell-specific, cell-type, developmentally or environmentally regulated expression profiles.

Furthermore, notwithstanding appellants' assertion

(Brief, page 9), there is no evidence on this record that any of the nucleic acid molecules depicted in SEQ ID NO: 1 through SEQ ID NO: 5 are tissue or cell-type specific, or developmentally or environmentally regulated. In this regard, we note that the claimed nucleic acid molecules were isolated from the cDNA library LIB3115. Specification, page 80, lines 5-6. There is no evidence on this record that LIB3115 is a subtractive cDNA library, wherein nucleic acid molecules from other maize tissue, or from other developmental stages, was subtracted (removed) from the library. Compare, for example, the subtractive cDNA library LIB3153 which is disclosed (specification, page 83, lines 17-19) to be "generated by subtracting driver cDNA, which is prepared from kernels harvested from 15 DAP [days after pollination] maize plants, from target cDNA, which is prepared from endosperms harvested from 5-8 day[s] after pollination (DAP) maize plants." In contrast to the claimed nucleic acid molecules, nucleic acid molecules SEQ ID NO: 24,931 through SEQ ID NO: 25,680 are from the subtractive cDNA library LIB3153.

In our opinion, the claimed nucleic acid molecules having the sequences identified as SEQ ID NO: 1 through SEQ ID NO: 5, represent five randomly selected nucleic acid molecules isolated from pooled leaf tissue at the time of anthesis. Notwithstanding appellants' emphasis on "anthesis," for the foregoing reasons, we find no evidence on this record that any of appellants' five randomly selected nucleic acid molecules are expressed only at the time of "anthesis." Accordingly, despite appellants' assertion to the contrary, there is no reasonable expectation that any of the claimed nucleic acid molecules would be capable of isolating a promoter that was only active in leaves at the time of anthesis. As appellants recognize (Brief, page 9), "[a] random nucleic acid molecule does not provide an equally good starting point to isolate such a promoter" compared to a nucleic acid molecule that is known to be specifically associated with this stage of plant development.

We recognize appellants' argument (Brief, bridging sentence, pages 9-10), "[a]n invention may be 'less effective than existing devices but nevertheless meet the statutory criteria for patentability.' *Custom Accessories, Inc. v. Jeffrey-Allan Indus.*, 807 F.2d 955, 960 n.12, 1 U.S.P.Q.2d 1196, 1199 n.12 (Fed. Cir. 1986)." While we agree with appellants' statement, we fail to see how it applies to appellants' claimed invention, wherein there is no evidence or expectation that the claimed nucleic acid molecules would be "effective" at all. In this regard, we remind appellants that an invention does not have utility

sufficient to satisfy § 101 until it is "refined and developed" to the point of providing a specific benefit \*1028 in currently available form. *See, e.g., Brenner*, 383 U.S. at 534, 148 USPQ at 695.

[4] An invention certainly can have a utility that is shared by other compounds or compositions. Take, for example, an application that claims ibuprofen and discloses that it is useful as an analgesic. No one would argue that a claim to ibuprofen lacks utility simply because aspirin and acetaminophen are also useful as analgesics. On the other hand, not every utility will satisfy § 101, even if the utility is shared by a class of inventions. Assume that the above-described application did not disclose that ibuprofen was an analgesic but only disclosed that it is useful because it can be used to fill a jar, which would then be useful as a paperweight. There would be little doubt that this disclosed utility would not satisfy § 101, even though the utility is shared by a large class of inventions, viz., those whose physical embodiments have mass. So while a utility need not be unique to a claimed invention, it must nonetheless be specific, and in currently available form, in order to satisfy § 101.

*c. Other Arguments*

Appellants argue that the specification "discloses additional utilities for the claimed nucleic acid molecules including introduction of the claimed nucleic acid molecules into a plant or plant cell (either as sense or antisense inhibitors), which can then be used to screen for compounds such as a herbicide." Brief, page 6. Specifically, appellants argue (*id.*) that "a compound can be provided to both an antisense plant and a control plant (no antisense) and the effect of the compound on the plant can be monitored." Appellants analogize this proposed procedure to a "cell-based assay" which appellants assert to have a "legally sufficient utility." *Id.*

[5] Suffice it to say that an otherwise uncharacterized nucleic acid molecule is being claimed in this application, not an assay. The portion of the specification cited in support of this argument (page 73, line 17 through page 74, line 17) indicates that the nucleic acid molecule must be introduced into a plant cell and transcribed using an appropriate promoter to result in the suppression of an endogenous protein. The specification does not indicate that such a method is feasible when the nucleic acid to be used is uncharacterized [FN5] as here. Such a use does not provide a specific or substantial benefit in currently available form.

[6] Appellants also argue that the claimed nucleic acids are useful to measure the level of mRNA in a sample through use of microarray technology and use as molecular markers. Brief, page 6. In regard to microarrays, appellants argue (*id.* fn. 3) that it is "standard practice" to screen populations of nucleic acids with EST sequences without characterizing each and every target mRNA. We find that the asserted utility of the claimed nucleic acid--as one component of an assay for monitoring gene expression--does not satisfy the utility requirement of § 101. Such a use does not provide a specific benefit in currently available form. We accept, for argument's sake, that a person skilled in the art could use the claimed nucleic acid, in combination with other nucleic acids, to monitor changes in expression of the gene that encompasses the nucleic acid depicted in e.g., SEQ ID NO: 1. However, the specification provides no guidance that would allow a skilled artisan to use data relating to expression of such a gene in any practical way. The specification simply provides no guidance regarding what the SEQ ID NO: 1-specific information derived from a gene expression experiment would mean. As the examiner points out (Answer, page 9), "the instant claimed nucleic acids appear to require further experimentation on the material itself to determine the function and properties of the claimed nucleic acids."

To highlight the examiner's assertion, suppose, for example, that a researcher found that SEQ ID NO: 1 expression was increased when a cell was treated with a particular agent. The specification provides no basis on which a skilled worker would be able to determine whether that result is meaningful. Maybe the meaning in a change in SEQ ID NO: 1 expression would depend on other factors, but again the specification provides no hint as to what other factors might be important. Would it depend on what agent is used, what cell type is used, the behavior of other genes (if so, which genes and what behavior is significant), the degree of increase? The specification simply provides no guidance as to how to interpret the results that might be seen using SEQ ID NO: 1 in a gene expression assay.

\*1029 In effect, appellants' position is that the claimed nucleic acids are useful because those of skill in the art could experiment with them and figure out for themselves what any observed experimental results might mean. We do not agree that such a disclosure provides a "specific benefit in currently available form." Rather, the present case seems analogous to *Brenner*. In *Brenner*, the applicant

claimed a method of making a compound but disclosed no utility for the compound. 383 U.S. at 529, 148 USPO at 693. The Court held that a process lacks utility if it produces a product that lacks utility. Id. at 534, 148 USPO at 695. Here, appellants claim a product asserted to be useful in a method of generating gene-expression data, but the specification does not disclose how to interpret those data. Just as the process claimed in *Brenner* lacked utility because the specification did not disclose how to use the end-product, the products claimed here lack utility, because even if used in gene expression assays, the specification does not disclose how to use SEQ ID NO: 1-specific gene expression data.

Assuming *arguendo*, that a generic gene expression assay--one based on monitoring expression of thousands of uncharacterized nucleic acids would provide a useful tool for, e.g., drug discovery, it does not follow that each one of the nucleic acids represented in the assay individually has patentable utility. Although each nucleic acid in the assay contributes to the data generated by the assay overall, the contribution of a single nucleic acid--its data point--is only a tiny contribution to the overall picture. The *Brenner* Court held that § 101 sets more than a *de minimis* standard for utility. Therefore, the patentable utility of a gene expression assay, for example, does not necessarily mean that each tiny component of the assay also has patentable utility. A patentable utility divided by a thousand does not necessarily equal a thousand patentable utilities. Each claimed invention must be shown to meet § 101's utility requirement in order to be patentable; it must provide a specific benefit in currently available form. Providing a single data point among thousands or millions, even if the thousands or millions of data points collectively are useful, does not meet this standard. The Supreme Court noted that the patent system contemplates a basic quid pro quo: in exchange for the legal right to exclude others from his invention for a period of time, an inventor discloses his invention to the public. *See Brenner*, 383 U.S. at 534, 148 USPO at 695. The *Brenner* Court held that the grant of patent rights to an applicant is justified only by disclosure of an invention with substantial utility -- a specific benefit in currently available form. Until the invention has been refined and developed to this point, the Court held, the applicant has not met his side of the bargain, and has not provided a disclosure sufficient to justify a grant of the right to exclude others. *See id.*

We reach the same conclusion in regard to appellants' assertion that the nucleic acid molecules depicted in SEQ ID NO: 1 through SEQ ID NO: 5 are

useful as a molecular marker or probe. It is not seen that the one data point which may be provided by using the uncharacterized nucleic acid molecule of SEQ ID NO: 1 as a molecular marker or probe represents a substantial use.

Appellants argue that ESTs have real world value as seen from the "growth of a multi-million dollar industry in the United States premised on the usefulness of ESTs." Brief, page 11. Since appellants fail to provide any suggestion on which use of ESTs this industry is premised on, we can only assume that appellants are referring to the potential usefulness of EST databases, clone sets or microarrays. Suffice it to say, the claims on appeal are not directed to EST databases, clone sets and/or microarrays. Again, it is not seen that the one data point which may be provided by using the uncharacterized nucleic acid molecules of SEQ ID NO: 1 through SEQ ID NO: 5 in such devices represents a substantial use.

For the foregoing reasons we affirm the rejection of claim 1 under 35 U.S.C. § 101.

#### Enablement

According to the examiner (Answer, page 13, emphasis removed), "since the claimed invention is not supported by either a specific, substantial asserted utility or a well established utility for the reasons set forth [in support of the rejection under 35 U.S.C. § 101] one skilled in the art clearly would not know how to use the claimed invention." This rejection is simply a corollary of the finding of lack of utility. Appellants assert (Brief, page 12), this rejection should be reversed for the same reasons set forth in their arguments regarding the rejection under 35 U.S.C. § 101. Thus, our conclusion with respect to the § 101 issue will also apply to this aspect of the § 112 (enablement) issue. On this basis we affirm the rejection of claim 1 under the enablement provision of 35 U.S.C. § 112, first paragraph.

#### \*1030 Written description

This rejection stands on a different footing. As we understand the examiner's argument the use of the transitional phrase "comprising" in appellants' claimed invention results in appellants claiming a large genus of nucleic acid molecules which are not adequately described by SEQ ID NO: 1 through SEQ ID NO: 5. Answer, pages 13-16. Apparently the examiner is of the opinion that the claimed invention should be limited to nucleic acid molecules as set forth in SEQ ID NO: 1 through SEQ ID NO: 5. In response appellants argue (Brief, page 14, original footnote omitted),

Applicants have provided the nucleotide sequences required by the claims, *i.e.*, SEQ ID NO: 1, SEQ ID NO: 2, SEQ ID NO: 3, SEQ ID NO: 4, and SEQ ID NO: 5, and have thus established possession of the claimed invention. The fact that the claims at issue are intended to cover molecules that include the recited sequences joined with additional sequences [FN6] ] does not mean that [a]pplicants were any less in possession of the claimed nucleic acid molecules.

[7] As discussed *supra*, as we understand the claimed invention, the use of the transitional term "comprising" does not allow for internal alterations (e.g. insertions or deletions) of the nucleotide sequences set forth in SEQ ID NO: 1 through SEQ ID NO: 5, but instead only allows for the addition of nucleotides or other molecules at either end of the nucleotide sequences set forth in SEQ ID NO: 1 through SEQ ID NO: 5. We agree with appellants that they have provided an adequate written description of nucleic acid molecules with the sequences set forth in SEQ ID NO: 1 through SEQ ID NO: 5. That the claimed nucleic acid molecules may have other molecules attached to either, or both of their 5' or 3' ends does not diminish appellants' adequate written description of the nucleic acids molecules with the sequences set forth in SEQ ID NO: 1 through SEQ ID NO: 5 as claimed.

Accordingly, we reverse the rejection of claim 1 under the written description provision of 35 U.S.C. § 112, first paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

#### AFFIRMED

FN1. During the Oral Hearing, appellants' representative confirmed that the administrative file contained no evidence that the claimed ESTs were capable of detecting a polymorphism that correlated with any particular trait.

FN2. This interpretation of the claimed invention was confirmed by appellants' representative during the Oral Hearing.

FN3. In discussing the issue of utility under 35 U.S.C. § 101, the Federal Circuit and the Court of Customs and Patent Appeals since *Brenner*, have used the phrases "substantial utility" and "practical utility"

interchangeably. *See e.g., Fujikawa v. Wattanasin*, 93 F.3d 1559, 1963-1964, 39 USPQ2d 1895, 1898-1899 (Fed. Cir. 1996) ("It is well established that a patent may not be granted to an invention unless substantial or practical utility for the invention has been discovered and disclosed.").

FN4. The invention at issue in *Brenner* was a process, but the Court expressly noted that its holding "would apply equally to the patenting of the product produced by the process." *Id.* at 535, 148 USPQ at 695-96.

FN5. To emphasize the uncharacterized nature of appellants' invention we note the examiner's finding (Answer, page 17) that translating SEQ ID NO: 5 in all 6 possible reading frames reveals that the sequence contains numerous stop codons which would terminate the translation of a protein, or protein fragment, encoded thereby.

FN6. By way of examples appellants explain (Brief, bridging paragraph, pages 14-15) that the specification discloses, *inter alia*, the claimed nucleic acid molecules joined together with vectors, and other nucleic acids (e.g. fusion nucleic acid molecules) and detectable labels.

982 F.2d 1554, 1560 (Fed.Cir.1992) (holding a C.F.R. provision invalid because it did not "comport with the clear statutory mandate"). Because § 831.2203(f) conflicts with and is no longer supported by the amendments to § 8343a, it is ineffective. Resort to that regulation to affect an AFA following the effective dates of amendments is foreclosed.

Here, Kievenaar's husband completed the annuity paperwork in February 2002. His annuity was to begin on July 1, 2002, and he died suddenly on July 22, 2002. Thus, his annuity commenced at a time when § 831.2203(f) was ineffective. While we are sympathetic to Kievenaar's position, we have no alternative but to conclude that she is not eligible for the AFA she seeks.

Because the unavailability of § 831.2203(f) during the period relevant to Kievenaar is dispositive of her case, we need not and do not decide the issue of validity of the regulation prior to the effective dates of the amendments to § 8343a.

#### CONCLUSION

The Board correctly determined that 5 C.F.R. § 831.2203(f) was inapplicable to Kievenaar's request to change her husband's self-only annuity to an AFA. The Board's affirmance of OPM's decision to deny the requested AFA was in accordance with law and is affirmed.

**AFFIRMED**



**In re Dane K. FISHER and  
Raghunath V. Lalgudi.**

**No. 04-1465.**

**United States Court of Appeals,  
Federal Circuit.**

**Sept. 7, 2005.**

**Background:** Applicants for patent covering "expressed sequence tags" for identifying nucleic acid sequences in maize genes challenged decision of United States Patent and Trademark Office Board of Patent Appeals and Interferences, 72 U.S.P.Q.2d 1020, 2004 WL 2185929, finding their claim unpatentable for lack of utility and lack of enablement.

**Holdings:** The Court of Appeals, Michel, Chief Judge, held that:

- (1) claimed invention lacked specific and substantial utility, and
- (2) application failed for lack of enablement.

**Affirmed.**

Rader, Circuit Judge, dissented and filed opinion.

#### **1. Patents ⇐314(5)**

Whether patent application discloses requisite utility for claimed invention is question of fact. 35 U.S.C.A. § 101.

#### **2. Patents ⇐48**

Patent application covering "expressed sequence tags" for identifying nucleic acid sequences in maize genes lacked requisite utility where tagged genes had no known functions; claimed tags acted as no more than research intermediates that might help scientists to isolate particular underlying protein-encoding genes and conduct further experimentation on those genes. 35 U.S.C.A. § 101.

### 3. Patents ⇐46

To be patentable, claimed invention must have substantial and specific "utility," i.e., invention must have significant and presently available benefit to public, and its claimed use must not be so vague as to be meaningless. 35 U.S.C.A. § 101.

See publication Words and Phrases for other judicial constructions and definitions.

### 4. Evidence ⇐48

#### Patents ⇐97

Manual of Patent Examining Procedure (MPEP) and Patent and Trademark Office's Utility Guidelines are not binding on court ruling on patent's validity, but may be given judicial notice to extent they do not conflict with patent statutes.

### 5. Patents ⇐99

Patent application for invention that lacks requisite utility also fails, as matter of law, for lack of enablement. 35 U.S.C.A. §§ 101, 112(1).

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Seth P. Waxman, Wilmer Cutler Pickering Hale and Dorr LLP, of Washington, DC, argued for appellants. With him on the brief were William F. Lee and Richard W. O'Neill, of Boston, Massachusetts; and William G. McElwain and Henry N. Wixon, of Washington, DC.

Stephen Walsh, Associate Solicitor, United States Patent and Trademark Office, of Arlington, Virginia, argued for the Director of the Patent and Trademark Office. With him on the brief were John M. Whealan, Solicitor, and Thomas W. Krause, Associate Solicitor.

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1. The real party in interest is Monsanto Technology LLC, which is owned by the Monsanto

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Jeffrey P. Kushan, Sidley Austin Brown & Wood, LLP, of Washington, DC, for amicus curiae Genentech, Inc. With him on the brief were Kathi A. Cover and David L. Fitzgerald.

George C. Yu, of Emeryville, California, for amicus curiae Affymetrix, Inc.

Before MICHEL, Chief Judge, RADER and BRYSON, Circuit Judges.

Opinion for the court filed by Chief Judge MICHEL.

Dissenting opinion filed by Circuit Judge RADER.

MICHEL, Chief Judge.

Dane K. Fisher and Raghunath Lalgudi (collectively "Fisher")<sup>1</sup> appeal from the decision of the U.S. Patent and Trademark Office ("PTO") Board of Patent Appeals and Interferences ("Board") affirming the examiner's final rejection of the only pending claim of application Serial No. 09/619,-

Company.

643 (the "'643 application"), entitled "Nucleic Acid Molecules and Other Molecules Associated with Plants," as unpatentable for lack of utility under 35 U.S.C. § 101 and lack of enablement under 35 U.S.C. § 112, first paragraph. *Ex parte Fisher*, App. No.2002-2046 (Bd.Pat.App.Int. Mar. 16, 2004) ("Board Decision"). This appeal was submitted after oral argument on May 3, 2005. Because we conclude that substantial evidence supports the Board's findings that the claimed invention lacks a specific and substantial utility and that the '643 application does not enable one of ordinary skill in the art to use the invention, we affirm.

## I. BACKGROUND

### A. Molecular Genetics and ESTs

The claimed invention relates to five purified nucleic acid sequences that encode proteins and protein fragments in maize plants. The claimed sequences are commonly referred to as "expressed sequence tags" or "ESTs." Before delving into the specifics of this case, it is important to understand more about the basic principles of molecular genetics and the role of ESTs.

Genes are located on chromosomes in the nucleus of a cell and are made of deoxyribonucleic acid ("DNA"). DNA is composed of two strands of nucleotides in double helix formation. The nucleotides contain one of four bases, adenine ("A"), guanine ("G"), cytosine ("C"), and thymine ("T"), that are linked by hydrogen bonds to form complementary base pairs (*i.e.*, A-T and G-C).

When a gene is expressed in a cell, the relevant double-stranded DNA sequence is transcribed into a single strand of messenger ribonucleic acid ("mRNA"). Messen-

ger RNA contains three of the same bases as DNA (A, G, and C), but contains uracil ("U") instead of thymine. mRNA is released from the nucleus of a cell and used by ribosomes found in the cytoplasm to produce proteins.

Complementary DNA ("cDNA") is produced synthetically by reverse transcribing mRNA. cDNA, like naturally occurring DNA, is composed of nucleotides containing the four nitrogenous bases, A, T, G, and C. Scientists routinely compile cDNA into libraries to study the kinds of genes expressed in a certain tissue at a particular point in time. One of the goals of this research is to learn what genes and downstream proteins are expressed in a cell so as to regulate gene expression and control protein synthesis.<sup>2</sup>

An EST is a short nucleotide sequence that represents a fragment of a cDNA clone. It is typically generated by isolating a cDNA clone and sequencing a small number of nucleotides located at the end of one of the two cDNA strands. When an EST is introduced into a sample containing a mixture of DNA, the EST may hybridize with a portion of DNA. Such binding shows that the gene corresponding to the EST was being expressed at the time of mRNA extraction.

Claim 1 of the '643 application recites:

A substantially purified nucleic acid molecule that encodes a maize protein or fragment thereof comprising a nucleic acid sequence selected from the group consisting of SEQ ID NO: 1 through SEQ ID NO: 5.

The ESTs set forth in SEQ ID NO: 1 through SEQ ID NO: 5 are obtained from cDNA library LIB3115, which was generated from pooled leaf tissue harvested

2. We have discussed the basic principles of molecular genetics more extensively in prior cases. See, *e.g.*, *In re Deuel*, 51 F.3d 1552, 1554-56 (Fed.Cir.1995); *Amgen, Inc. v. Chu-*

*gai Pharm. Co., Ltd.*, 927 F.2d 1200, 1207-08 (Fed.Cir.1991); *In re O'Farrell*, 853 F.2d 894, 895-99 (Fed.Cir.1988).



from maize plants (RX601, Asgrow Seed Company, Des Moines, Iowa, U.S.A.) grown in the fields at Asgrow research stations. SEQ ID NO:1 through SEQ ID NO:5 consist of 429, 423, 365, 411, and 331 nucleotides, respectively. When Fisher filed the '643 application, he claimed ESTs corresponding to genes expressed from the maize pooled leaf tissue at the time of anthesis. Nevertheless, Fisher did not know the precise structure or function of either the genes or the proteins encoded for by those genes.

The '643 application generally discloses that the five claimed ESTs may be used in a variety of ways, including: (1) serving as a molecular marker for mapping the entire maize genome, which consists of ten chromosomes that collectively encompass roughly 50,000 genes; (2) measuring the level of mRNA in a tissue sample via microarray technology to provide information about gene expression; (3) providing a source for primers for use in the polymerase chain reaction ("PCR") process to enable rapid and inexpensive duplication of specific genes; (4) identifying the presence or absence of a polymorphism; (5) isolating promoters via chromosome walking; (6) controlling protein expression; and (7) locating genetic molecules of other plants and organisms.

#### B. Final Rejection

In a final rejection, dated September 6, 2001, the examiner rejected claim 1 for lack of utility under § 101. The examiner found that the claimed ESTs were not supported by a specific and substantial utility. She concluded that the disclosed uses were not specific to the claimed ESTs, but instead were generally applicable to any EST. For example, the examiner noted that any EST may serve as a molecular tag to isolate genetic regions. She also concluded that the claimed ESTs lacked a substantial utility because there was no known use for the proteins pro-

duced as final products resulting from processes involving the claimed ESTs. The examiner stated: "Utilities that require or constitute carrying out further research to identify or reasonably confirm a 'real world' context of use are not substantial utilities."

The examiner also rejected the claimed application for lack of enablement under § 112, first paragraph. She reasoned that one skilled in the art would not know how to use the claimed ESTs because the '643 application did not disclose a specific and substantial utility for them.

On July 19, 2000, Fisher filed a notice of appeal with the Board.

#### C. Board Proceedings

The Board considered each of Fisher's seven potential uses but noted that Fisher focused its appeal on only two: (1) use for the identification of polymorphisms; and (2) use as probes or as a source for primers. As to the first, the Board found that the application failed to explain why the claimed ESTs would be useful in detecting polymorphisms in maize plants. *Board Decision*, slip op. at 14. The Board reasoned that "[w]ithout knowing any further information in regard to the gene represented by an EST, as here, detection of the presence or absence of a polymorphism provides the barest information in regard to genetic heritage." *Id.*, slip op. at 15. Thus, the Board concluded that Fisher's asserted uses for the claimed ESTs tended to the "insubstantial use" end of the spectrum between a substantial and an insubstantial utility. *Id.*

The Board also concluded that using the claimed ESTs to isolate nucleic acid molecules of other plants and organisms, which themselves had no known utility, is not a substantial utility. *Id.*, slip op. at 16. Specifically, the Board noted that Fisher argued that the "claimed ESTs may be

useful in searching for promoters that are only active in leaves at the time of anthesis." *Id.* The Board found, however, that the application failed to show that the claimed ESTs would be expressed only during anthesis or that they would be capable of isolating a promoter active in maize leaves at the time of anthesis. *Id.*, slip op. at 18.

Additionally, the Board addressed the remaining asserted utilities, highlighting in particular the use of the claimed ESTs to monitor gene expression by measuring the level of mRNA through microarray technology and to serve as molecular markers. The Board found that using the claimed ESTs in screens does not provide a specific benefit because the application fails to provide any teaching regarding how to use the data relating to gene expression. *Id.*, slip op. at 21. The Board analogized the facts to those in *Brenner v. Manson*, 383 U.S. 519, 86 S.Ct. 1033, 16 L.Ed.2d 69 (1966), in which an applicant claimed a process of making a compound having no known use. In that case, the Supreme Court affirmed the rejection of the application on § 101 grounds. Here, the Board reasoned: "Just as the process in *Brenner* lacked utility because the specification did not disclose how to use the end-product, the products claimed here lack utility, because even if used in gene expression assays, the specification does not disclose how to use SEQ ID NO: 1-5 specific gene expression data." *Id.*, slip op. at 22. The Board offered a similar rationale for the use of the claimed ESTs as molecular markers. *Id.*, slip op. at 24. Accordingly, the Board affirmed the examiner's rejection of the '643 application for lack of utility under § 101. The Board also affirmed the examiner's rejection of the '643 application for lack of enablement under § 112, first paragraph, since the enablement rejection was made as a corollary to the utility rejection.

Fisher timely appealed. We have jurisdiction over this appeal pursuant to 28 U.S.C. § 1295(a)(4) and 35 U.S.C. §§ 141 and 144.

## II. DISCUSSION

[1] Whether an application discloses a utility for a claimed invention is a question of fact. *In re Ziegler*, 992 F.2d 1197, 1200 (Fed.Cir.1993). We consequently review the Board's determination that the '643 application failed to satisfy the utility requirement of § 101 for substantial evidence. *In re Gartside*, 203 F.3d 1305, 1315 (Fed.Cir.2000) ("Because our review of the Board's decision is confined to the factual record compiled by the Board, we accordingly conclude that the 'substantial evidence' standard is appropriate for our review of Board factfindings.").

### A. Utility

#### 1.

[2] Fisher asserts that the Board unilaterally applied a heightened standard for utility in the case of ESTs, conditioning patentability upon "some undefined 'spectrum' of knowledge concerning the corresponding gene function." Fisher contends that the standard is not so high and that Congress intended the language of § 101 to be given broad construction. In particular, Fisher contends that § 101 requires only that the claimed invention "not be frivolous, or injurious to the well-being, good policy, or good morals of society," essentially adopting Justice Story's view of a useful invention from *Lowell v. Lewis*, 15 F.Cas. 1018, 1019 (No. 8568) (C.C.D.Mass. 1817). Under the correct application of the law, Fisher argues, the record shows that the claimed ESTs provide seven specific and substantial uses, regardless whether the functions of the genes corresponding to the claimed ESTs are known. Fisher claims that the Board's attempt to

equate the claimed ESTs with the chemical compositions in *Brenner* was misplaced and that several decisions in the field of pharmaceuticals, namely, *Cross v. Iizuka*, 753 F.2d 1040 (Fed.Cir.1985), *Nelson v. Bowler*, 626 F.2d 853 (C.C.P.A.1980), and *In re Jolles*, 628 F.2d 1322 (C.C.P.A.1980), are analogous and support finding utility of the claimed ESTs. Fisher likewise argues that the general commercial success of ESTs in the marketplace confirms the utility of the claimed ESTs. Hence, Fisher avers that the Board's decision was not supported by substantial evidence and should be reversed.

The government agrees with Fisher that the utility threshold is not high, but disagrees with Fisher's allegation that the Board applied a heightened utility standard. The government contends that a patent applicant need disclose only a single specific and substantial utility pursuant to *Brenner*, the very standard articulated in the PTO's "Utility Examination Guidelines" ("Utility Guidelines") and followed here when examining the '643 application. It argues that Fisher failed to meet that standard because Fisher's alleged uses are so general as to be meaningless. What is more, the government asserts that the same generic uses could apply not only to the five claimed ESTs but also to any EST derived from any organism. It thus argues that the seven utilities alleged by Fisher are merely starting points for further research, not the end point of any research effort. It further disputes the importance of the commercial success of ESTs in the marketplace, pointing out that Fisher's evidence involved only databases, clone sets, and microarrays, not the five claimed ESTs. Therefore, the government

contends that we should affirm the Board's decision.

Several academic institutions and biotechnology and pharmaceutical companies<sup>3</sup> write as amici curiae in support of the government. Like the government, they assert that Fisher's claimed uses are nothing more than a "laundry list" of research plans, each general and speculative, none providing a specific and substantial benefit in currently available form. The amici also advocate that the claimed ESTs are the objects of further research aimed at identifying what genes of unknown function are expressed during anthesis and what proteins of unknown function are encoded for by those genes. Until the corresponding genes and proteins have a known function, the amici argue, the claimed ESTs lack utility under § 101 and are not patentable.

[3] We agree with both the government and the amici that none of Fisher's seven asserted uses meets the utility requirement of § 101. Section 101 provides: "Whoever invents . . . any new and *useful* . . . composition of matter . . . may obtain a patent therefor . . ." (Emphasis added). In *Brenner*, the Supreme Court explained what is required to establish the usefulness of a new invention, noting at the outset that "a simple, everyday word ["useful," as found in § 101] can be pregnant with ambiguity when applied to the facts of life." 383 U.S. at 529, 86 S.Ct. 1033. Contrary to Fisher's argument that § 101 only requires an invention that is not "frivolous, injurious to the well-being, good policy, or good morals of society," the Supreme Court appeared to reject Justice Story's de minimis view of utility. *Id.* at 532-33, 86 S.Ct. 1033 (citation omitted).

3. Amici in support of the government include Affymetrix, Inc., American College of Medical Genetics, Association of American Medical Colleges, Baxter Healthcare Corporation,

Dow AgroSciences LLC, Eli Lilly and Company, Genentech, Inc., National Academy of Sciences, and the University of North Carolina School of Law.

The Supreme Court observed that Justice Story's definition "sheds little light on our subject," on the one hand framing the relevant inquiry as "whether the invention in question is 'frivolous and insignificant' " if narrowly read, while on the other hand "allowing the patenting of any invention not positively harmful to society" if more broadly read. *Id.* at 533, 86 S.Ct. 1033. In its place, the Supreme Court announced a more rigorous test, stating:

The basic *quid pro quo* contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with *substantial utility*. Unless and until a process is refined and developed to this point—where *specific benefit exists in currently available form*—there is insufficient justification for permitting an applicant to engross what may prove to be a broad field.

*Brenner*, 383 U.S. at 534–35, 86 S.Ct. 1033 (emphases added). Following *Brenner*, our predecessor court, the Court of Customs and Patent Appeals, and this court have required a claimed invention to have a specific and substantial utility to satisfy § 101. *See, e.g., Fujikawa v. Wattanasin*, 93 F.3d 1559, 1563 (Fed.Cir.1996) ("Consequently, it is well established that a patent may not be granted to an invention unless substantial or practical utility for the invention has been discovered and disclosed.").

The Supreme Court has not defined what the terms "specific" and "substantial" mean per se. Nevertheless, together with the Court of Customs and Patent Appeals, we have offered guidance as to the uses which would meet the utility standard of § 101. From this, we can discern the kind of disclosure an application must contain to establish a specific and substantial utility for the claimed invention.

Courts have used the labels "practical utility" and "real world" utility interchangeably in determining whether an invention offers a "substantial" utility. Indeed, the Court of Customs and Patent Appeals stated that "[p]ractical utility" is a shorthand way of attributing 'real-world' value to claimed subject matter. In other words, one skilled in the art can use a claimed discovery in a manner which provides some *immediate benefit to the public*." *Nelson*, 626 F.2d at 856 (emphasis added).<sup>4</sup> It thus is clear that an application must show that an invention is useful to the public as disclosed in its current form, not that it may prove useful at some future date after further research. Simply put, to satisfy the "substantial" utility requirement, an asserted use must show that that claimed invention has a significant and presently available benefit to the public.

Turning to the "specific" utility requirement, an application must disclose a use which is not so vague as to be meaningless. Indeed, one of our predecessor courts has observed "that the nebulous expressions 'biological activity' or 'biological properties' appearing in the specification convey no more explicit indication of the usefulness of the compounds and how to use them than did the equally obscure expression 'useful for technical and pharmaceutical purposes' unsuccessfully relied upon by the appellant in *In re Diedrich* [318 F.2d 946, 50 C.C.P.A. 1355 (1963)]." *In re Kirk*, 54 C.C.P.A. 1119, 376 F.2d 936, 941 (1967). Thus, in addition to providing a "substantial" utility, an asserted use must also show that that claimed invention can be used to provide a well-defined and particular benefit to the public.

4. In *Cross*, this court considered the phrase "practical utility" to be synonymous with the

phrase "substantial utility." 753 F.2d at 1047, n. 13.

[4] In 2001, partially in response to questions about the patentability of ESTs, the PTO issued Utility Guidelines governing its internal practice for determining whether a claimed invention satisfies § 101. See Utility Examination Guidelines, 66 Fed.Reg. 1092 (Jan. 5, 2001). The PTO incorporated these guidelines into the Manual of Patent Examining Procedure ("MPEP"). See U.S. Pat. & Trademark Off., Manual of Patent Examining Procedure § 2107 (8th ed.2001, rev. May 2004). The MPEP and Guidelines "are not binding on this court, but may be given judicial notice to the extent they do not conflict with the statute." *Enzo Biochem v. Gen-Probe*, 323 F.3d 956, 964 (Fed.Cir. 2002) (citing *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n. 10 (Fed.Cir.1995)). According to the Utility Guidelines, a specific utility is particular to the subject matter claimed and would not be applicable to a broad class of invention. Manual of Patent Examining Procedure § 2107.01. The Utility Guidelines also explain that a substantial utility defines a "real world" use. In particular, "[u]tilities that require or constitute carrying out further research to identify or reasonably confirm a 'real world' context of use are not substantial utilities." *Id.* Further, the Utility Guidelines discuss "research tools," a term often given to inventions used to conduct research. The PTO particularly cautions that

[a]n assessment that focuses on whether an invention is useful only in a research setting thus does not address whether the invention is in fact "useful" in a patent sense. [The PTO] must distinguish between inventions that have a specifically identified substantial utility and inventions whose asserted utility requires further research to identify or reasonably confirm.

*Id.* The PTO's standards for assessing whether a claimed invention has a specific and substantial utility comport with this

court's interpretation of the utility requirement of § 101.

Turning to the parties' arguments, Fisher first raises a legal issue, charging that the Board applied a heightened standard for utility in the case of ESTs. Fisher apparently bases this argument on statements made by the Board in connection with its discussion of whether the claimed ESTs can be used to identify a polymorphism. In that context, the Board stated:

Somewhere between having no knowledge (the present circumstances) and having complete knowledge of the gene and its role in the plant's development lies the line between 'utility' and 'substantial utility.' We need not draw the line or further define it in this case because the facts in this case represent the lowest end of the *spectrum*, i.e., an insubstantial use.

*Board Decision*, slip op. at 15 (emphasis added). Fisher reads the word "spectrum" out of context, claiming that the word somehow implies the application of a higher standard for utility than required by § 101. We conclude, however, that the Board did not apply an incorrect legal standard. In its decision, the Board made reference to a "spectrum" to differentiate between a substantial utility, which satisfies the utility requirement of § 101, and an insubstantial utility, which fails to satisfy § 101. The Board plainly did not announce or apply a new test for assessing the utility of ESTs. It simply followed the Utility Guidelines and MPEP, which mandate the specific and substantial utility test set forth in *Brenner*. Indeed, we note that Example 9 of the PTO's "Revised Interim Utility Guidelines Training Materials" is applicable to the facts here. See U.S. Pat. & Trademark Off., Revised Interim Utility Guidelines Training Materials 50-53 (1999), available at [www.uspto.gov/web/menu/utility.pdf](http://www.uspto.gov/web/menu/utility.pdf). In that example, a cDNA

fragment disclosed as being useful as a probe to obtain the full length gene corresponding to a cDNA fragment was deemed to lack a specific and substantial utility. Additionally, the MPEP particularly explains that a claim directed to a polynucleotide disclosed to be useful as a "gene probe" or "chromosome marker," as is the case here, fails to satisfy the specific utility requirement unless a specific DNA target is also disclosed. Manual of Patent Examining Procedure § 2107.01.

Regarding the seven uses asserted by Fisher, we observe that each claimed EST uniquely corresponds to the single gene from which it was transcribed ("underlying gene"). As of the filing date of the '643 application, Fisher admits that the underlying genes have no known functions. Fisher, nevertheless, claims that this fact is irrelevant because the seven asserted uses are not related to the functions of the underlying genes. We are not convinced by this contention. Essentially, the claimed ESTs act as no more than research intermediates that may help scientists to isolate the particular underlying protein-encoding genes and conduct further experimentation on those genes. The overall goal of such experimentation is presumably to understand the maize genome—the functions of the underlying genes, the identity of the encoded proteins, the role those proteins play during anthesis, whether polymorphisms exist, the identity of promoters that trigger protein expression, whether protein expression may be controlled, etc. Accordingly, the claimed ESTs are, in words of the Supreme Court, mere "object[s] of use-testing," to wit, objects upon which scientific research could be performed with no assurance that anything useful will be discovered in the end. *Brenner*, 383 U.S. at 535, 86 S.Ct. 1033.

Fisher compares the claimed ESTs to certain other patentable research tools, such as a microscope. Although this com-

parison may, on first blush, be appealing in that both a microscope and one of the claimed ESTs can be used to generate scientific data about a sample having unknown properties, Fisher's analogy is flawed. As the government points out, a microscope has the specific benefit of optically magnifying an object to immediately reveal its structure. One of the claimed ESTs, by contrast, can only be used to detect the presence of genetic material having the same structure as the EST itself. It is unable to provide any information about the overall structure let alone the function of the underlying gene. Accordingly, while a microscope can offer an immediate, real world benefit in a variety of applications, the same cannot be said for the claimed ESTs. Fisher's proposed analogy is thus inapt. Hence, we conclude that Fisher's asserted uses are insufficient to meet the standard for a "substantial" utility under § 101.

Moreover, all of Fisher's asserted uses represent merely hypothetical possibilities, objectives which the claimed ESTs, or any EST for that matter, *could* possibly achieve, but none for which they have been used in the real world. Focusing on the two uses emphasized by Fisher at oral argument, Fisher maintains that the claimed ESTs could be used to identify polymorphisms or to isolate promoters. Nevertheless, in the face of a utility rejection, Fisher has not presented any evidence, as the Board well noted, showing that the claimed ESTs have been used in either way. That is, Fisher does not present either a single polymorphism or a single promoter, assuming at least one of each exists, actually identified by using the claimed ESTs. Further, Fisher has not shown that a polymorphism or promoter so identified would have a "specific and substantial" use. The Board, in fact, correctly recognized this very deficiency and cited it

as one of the reasons for upholding the examiner's final rejection.

With respect to the remaining asserted uses, there is no disclosure in the specification showing that any of the claimed ESTs were used as a molecular marker on a map of the maize genome. There also is no disclosure establishing that any of the claimed ESTs were used or, for that matter, could be used to control or provide information about gene expression. Significantly, despite the fact that maize leaves produce over two thousand different proteins during anthesis, Fisher failed to show that one of the claimed ESTs translates into a portion of one of those proteins. Fisher likewise did not provide any evidence showing that the claimed ESTs were used to locate genetic molecules in other plants and organisms. What is more, Fisher has not proffered any evidence showing that any such generic molecules would themselves have a specific and substantial utility. Consequently, because Fisher failed to prove that its claimed ESTs can be successfully used in the seven ways disclosed in the '643 application, we have no choice but to conclude that the claimed ESTs do not have a "substantial" utility under § 101.

Furthermore, Fisher's seven asserted uses are plainly not "specific." Any EST transcribed from any gene in the maize genome has the potential to perform any one of the alleged uses. That is, any EST transcribed from any gene in the maize genome may be a molecular marker or a source for primers. Likewise, any EST transcribed from any gene in the maize genome may be used to measure the level of mRNA in a tissue sample, identify the presence or absence of a polymorphism, isolate promoters, control protein expression, or locate genetic molecules of other plants and organisms. Nothing about Fisher's seven alleged uses set the five claimed ESTs apart from the more than

32,000 ESTs disclosed in the '643 application or indeed from any EST derived from any organism. Accordingly, we conclude that Fisher has only disclosed general uses for its claimed ESTs, not specific ones that satisfy § 101.

We agree with the Board that the facts here are similar to those in *Brenner*. There, as noted above, the applicant claimed a process for preparing compounds of unknown use. Similarly, Fisher filed an application claiming five particular ESTs which are capable of hybridizing with underlying genes of unknown function found in the maize genome. The *Brenner* court held that the claimed process lacked a utility because it could be used only to produce a compound of unknown use. The *Brenner* court stated: "We find absolutely no warrant for the proposition that although Congress intended that no patent be granted on a chemical compound whose sole 'utility' consists of its potential role as an object of use-testing, a different set of rules was meant to apply to the process which yielded the unpatentable product." 383 U.S. at 535, 86 S.Ct. 1033. Applying that same logic here, we conclude that the claimed ESTs, which do not correlate to an underlying gene of known function, fail to meet the standard for utility intended by Congress.

In addition to approving of the Board's reliance on *Brenner*, we observe that the facts here are even more analogous to those presented in *Kirk*, 54 C.C.P.A. 1119, 376 F.2d 936, and *In re Joly*, 54 C.C.P.A. 1159, 376 F.2d 906 (1967), two cases decided by our predecessor court shortly after *Brenner*. In *Kirk*, the applicant sought to patent new steroidal compounds disclosed as having two possible utilities. First, the applicant alleged that the claimed compounds were useful for their "biological activity" because "one skilled in the art would know how to use the compounds ...

to take advantage of their presently-existing biological activity.” *Kirk*, 376 F.2d at 939. The court rejected this claimed utility on the ground that it was not sufficiently “specific,” but was instead “nebulous.” *Id.* at 941.

Second, the applicant asserted that the claimed compounds could be used by skilled chemists as intermediates in the preparation of final steroidal compounds of unknown use. Relying on *Brenner*, the court reasoned:

It seems clear that, if a process for producing a product of only conjectural use is not itself “useful” within § 101, it cannot be said that the starting materials for such a process—i.e., the presently claimed intermediates—are “useful.” It is not enough that the specification disclose that the intermediate exists and that it “works,” reacts, or can be used to produce some intended product of no known use. Nor is it enough that the product disclosed to be obtained from the intermediate belongs to some class of compounds which now is, or in the future might be, the subject of research to determine some *specific use*. Cf. *Reiners v. Mehlretter*, 43 C.C.P.A. 1019, 236 F.2d 418, 421 [(C.C.P.A.1956)] where compounds employed as intermediates to produce other directly useful compounds were found to be themselves useful.

*Id.* at 945–46 (emphasis added). Therefore, the court affirmed the Board’s rejection of the claimed compounds for lack of utility.

The facts in *Joly* are nearly identical to the facts in *Kirk*. The *Joly* applicant filed an application claiming compounds useful as intermediates in preparing steroids that were themselves not shown or known to be useful, but that were similar in chemical structure to steroids of known pharmacological usefulness. The court adopted the reasoning of the *Kirk* court in its entirety

and affirmed the Board’s decision rejecting the claimed intermediates for failing to comply with § 101. *Joly*, 376 F.2d at 908–09.

Just as the claimed compounds in *Kirk* and *Joly* were useful only as intermediates in the synthesis of other compounds of unknown use, the claimed ESTs can only be used as research intermediates in the identification of underlying protein-encoding genes of unknown function. The rationale of *Kirk* and *Joly* thus applies here. In the words of the *Kirk* court:

We do not believe that it was the intention of the statutes to require the Patent Office, the courts, or the public to play the sort of guessing game that might be involved if an applicant could satisfy the requirements of the statutes by indicating the usefulness of a claimed compound *in terms of possible use so general as to be meaningless* and then, after his research or that of his competitors has definitely ascertained an actual use for the compound, adducing evidence intended to show that a particular specific use would have been obvious to men skilled in the particular art to which this use relates.

376 F.2d at 942 (emphasis added).

That the *Kirk* and *Joly* decisions involved chemical compounds, while the present case involves biological entities, does not distinguish these decisions. The rationale presented therein, having been drawn from principles set forth by the Supreme Court in *Brenner*, applies with equal force in the fields of chemistry and biology as well as in any scientific discipline. In *Brenner*, the Supreme Court was primarily concerned with creating an unwarranted monopoly to the detriment of the public:

Whatever weight is attached to the value of encouraging disclosure and of inhibiting secrecy, we believe a more compel-



ling consideration is that a process patent in the chemical field, which has not been developed and pointed to the degree of specific utility, creates a monopoly of knowledge which should be granted only if clearly commanded by the statute. Until the process claim has been reduced to production of a product shown to be useful, the metes and bounds of that monopoly are not capable of precise delineation. It may engross a vast, unknown, and perhaps unknowable area. Such a patent may confer power to block off whole areas of scientific development, without compensating benefit to the public. . . . This is not to say that we mean to disparage the importance of contributions to the fund of scientific information short of the invention of something "useful," or that we are blind to the prospect that what now seems without "use" may tomorrow command the grateful attention of the public. But a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion. [A] patent system must be related to the world of commerce rather than to the realm of philosophy.

*Brenner*, 383 U.S. at 535-36, 86 S.Ct. 1033 (citations, quotation, and footnote omitted). Here, granting a patent to Fisher for its five claimed ESTs would amount to a hunting license because the claimed ESTs can be used only to gain further information about the underlying genes and the proteins encoded for by those genes. The claimed ESTs themselves are not an end of Fisher's research effort, but only tools to be used along the way in the search for a practical utility. Thus, while Fisher's claimed ESTs may add a noteworthy contribution to biotechnology research, our precedent dictates that the '643 application does not meet the utility requirement of § 101 because Fisher does not identify the function for the underlying protein-encoding genes. Absent such identification, we

hold that the claimed ESTs have not been researched and understood to the point of providing an immediate, well-defined, real world benefit to the public meriting the grant of a patent.

2.

Fisher's reliance on *Jolles*, *Nelson*, and *Cross*, cases which found utility in certain claimed pharmaceutical compounds, is misplaced. In *Jolles*, the applicant filed an application claiming naphthacene compounds useful in treating acute myeloblastic leukemia. To support the asserted utility, the applicant presented *in vivo* data showing eight of the claimed compounds effectively treated tumors in a mouse model. Our predecessor court reversed the Board's affirmance of the final rejection for lack of utility, finding that the structural similarity between the compounds tested *in vivo* and the remaining claimed compounds was sufficient to establish utility for the remaining claimed compounds. *Jolles*, 628 F.2d at 1327-28.

In *Nelson*, decided by the Court of Customs and Patent Appeals in the same year as *Jolles*, Nelson claimed prostaglandin compounds. The PTO declared an interference with an application filed by Bowler claiming the same compounds. The issue before the Board was whether Nelson had established utility for the claimed prostaglandins as smooth muscle stimulants and blood pressure modulators via *in vivo* and *in vitro* data, specifically, an *in vivo* rat blood pressure test and an *in vitro* gerbil colon smooth muscle stimulation test. The Board declined to award priority to Nelson, characterizing Nelson's tests as "rough screens, uncorrelated with actual utility [in humans]." Our predecessor court reversed, concluding that "tests evidencing pharmacological activity may manifest a practical utility even though they may not establish a specific therapeutic use." *Nelson*, 626 F.2d at 856.

In *Cross*, decided by the Federal Circuit five years after *Jolles* and *Nelson*, *lizuka* filed an application claiming thromboxane synthetase inhibitors, alleged to be useful in treating inflammation, asthma, hypertension, and other ailments. When *Cross* filed an application claiming the same compounds two months after *lizuka*, the PTO declared an interference. The dispositive issue concerned whether *lizuka*'s Japanese priority application disclosed utility for the claimed inhibitors. The Board concluded that it offered a sufficient disclosure based upon *in vitro* data showing strong inhibitory action for thromboxane synthetase for structurally-similar compounds in human or bovine platelet microsomes. We affirmed, reasoning:

Opinions of our predecessor court have recognized the fact that pharmacological testing of animals is a screening procedure for testing new drugs for practical utility. This *in vivo* testing is but an intermediate link in a screening chain which may eventually lead to the use of the drug as a therapeutic agent in humans. We perceive no insurmountable difficulty, under appropriate circumstances, in finding that the first link in the screening chain, *in vitro* testing, may establish a practical utility for the compound in question. Successful *in vitro* testing will marshal resources and direct the expenditure of effort to further *in vivo* testing of the most potent compounds, thereby providing an immediate benefit to the public, analogous to the benefit provided by the showing of an *in vivo* utility.

*Cross*, 753 F.2d at 1050 (citations omitted).

The facts in these three cases are readily distinguishable from the facts here. In *Jolles*, *Nelson*, and *Cross*, the applicants disclosed specific pharmaceutical uses in humans for the claimed compounds and supported those uses with specific animal test data, *in vitro*, *in vivo*, or both. In contrast, *Fisher* disclosed a variety of as-

serted uses for the claimed ESTs, but failed to present any evidence—test data, declaration, deposition testimony, or otherwise—to support those uses as presently beneficial and hence practical. *Fisher* did not show that even one of the claimed ESTs had been tested and successfully aided in identifying a polymorphism in the maize genome or in isolating a single promoter that could give clues about protein expression. Adopting the language of the *Cross* court, the alleged uses in *Jolles*, *Nelson*, and *Cross* were not “nebulous expressions, such as ‘biological activity’ or ‘biological properties’ [alleged in the application in *Kirk*],” that “convey little explicit indication regarding the utility of a compound.” *Cross*, 753 F.2d at 1048. Instead, the alleged uses in those cases gave a firm indication of the precise uses to which the claimed compounds could be put. For example, in *Nelson*, the claimed prostaglandins could be used to stimulate smooth muscle or modulate blood pressure in humans as shown by both *in vivo* and *in vitro* animal data. Hence, the *Jolles*, *Nelson*, and *Cross* courts concluded that the claimed pharmaceutical compounds satisfied the specific and substantial utility requirements of § 101. We cannot reach that same conclusion here. *Fisher*'s laundry list of uses, like the terms “biological activity” or “biological properties” alleged in *Kirk*, are nebulous, especially in the absence of any data demonstrating that the claimed ESTs were actually put to the alleged uses.

*Fisher*'s reliance on the commercial success of general EST databases is also misplaced because such general reliance does not relate to the ESTs at issue in this case. *Fisher* did not present any evidence showing that agricultural companies have purchased or even expressed any interest in the claimed ESTs. And, it is entirely unclear from the record whether such business entities ever will. Accordingly, while

commercial success may support the utility of an invention, it does not do so in this case. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 959 (Fed.Cir.1983) (stating that proof of a utility may be supported when a claimed invention meets with commercial success).

3.

As a final matter, we observe that the government and its amici express concern that allowing EST patents without proof of utility would discourage research, delay scientific discovery, and thwart progress in the "useful Arts" and "Science." See U.S. Const. art. I, § 8, cl. 8. The government and its amici point out that allowing EST claims like Fisher's would give rise to multiple patents, likely owned by several different companies, relating to the same underlying gene and expressed protein. Such a situation, the government and amici predict, would result in an unnecessarily convoluted licensing environment for those interested in researching that gene and/or protein.

The concerns of the government and amici, which may or may not be valid, are not ones that should be considered in deciding whether the application for the claimed ESTs meets the utility requirement of § 101. The same may be said for the resource and managerial problems that the PTO potentially would face if applicants present the PTO with an onslaught of patent applications directed to particular ESTs. Congress did not intend for these practical implications to affect the determination of whether an invention satisfies the requirements set forth in 35 U.S.C. §§ 101, 102, 103, and 112. They are public policy considerations which are more appropriately directed to Congress as the legislative branch of government, rather than this court as a judicial body responsible simply for interpreting and applying statutory law. Under Title 35, an applicant is entitled to a patent if his in-

vention is new, useful, nonobvious, and his application adequately describes the claimed invention, teaches others how to make and use the claimed invention, and discloses the best mode for practicing the claimed invention. What is more, when Congress enacted § 101, it indicated that "anything under the sun that is made by man" constitutes potential subject matter for a patent. S.Rep. No. 82-1979, at 7 (1952), U.S.Code Cong. & Admin.News at 2394, 2399. Policy reasons aside, because we conclude that the utility requirement of § 101 is not met, we hold that Fisher is not entitled to a patent for the five claimed ESTs.

#### B. Enablement

[5] Fisher asserts that we should reverse the enablement rejection upheld by the Board since the Board made it contingent upon the utility rejection, which Fisher argues was not supported by substantial evidence for reasons analyzed above. The government argues to the contrary, asserting that claim 1 of the '643 application cannot be enabled because the claimed ESTs were not disclosed as having a specific and substantial utility. We agree with the government. It is well established that the enablement requirement of § 112 incorporates the utility requirement of § 101.

The how to use prong of section 112 incorporates as a matter of law the requirement of 35 U.S.C. § 101 that the specification disclose as a matter of fact a practical utility for the invention. If the application fails as a matter of fact to satisfy 35 U.S.C. § 101, then the application also fails as a matter of law to enable one of ordinary skill in the art to use the invention under 35 U.S.C. § 112.

*Ziegler*, 992 F.2d at 1200-01 (citations omitted); see also *Kirk*, 376 F.2d at 942 ("Necessarily, compliance with § 112 re-

quires a description of how to use presently useful inventions, otherwise an applicant would anomalously be required to teach how to use a useless invention.”); *In re Brana*, 51 F.3d 1560, 1564 (Fed.Cir.1995) (“Obviously, if a claimed invention does not have utility, the specification cannot enable one to use it.”); Manual of Patent Examining Procedure § 2107.01. Here, in light of our conclusion that the Board’s decision with respect to utility applied the correct legal standard and was supported by substantial evidence, we conclude that Fisher failed to satisfy the enablement requirement. Consequently, we leave undisturbed the enablement rejection of the ’643 application under § 112, first paragraph.

### III. CONCLUSION

We conclude that substantial evidence supports the Board’s findings that each of the five claimed ESTs lacks a specific and substantial utility and that they are not enabled. Accordingly, the Board’s decision affirming the final rejection of claim 1 of the ’643 patent for lack of utility under § 101 and lack of enablement under § 112, first paragraph, is affirmed.

#### AFFIRMED.

RADER, Circuit Judge, dissenting.

This court today determines that expressed sequence tags (ESTs) do not satisfy 35 U.S.C. § 101 unless there is a known use for the genes from which each EST is transcribed. While I agree that an invention must demonstrate utility to satisfy § 101, these claimed ESTs have such a utility, at least as research tools in isolating and studying other molecules. Therefore, I respectfully dissent.

Several, if not all, of Fisher’s asserted utilities claim that ESTs function to study other molecules. In simple terms, ESTs are research tools. Admittedly ESTs have use only in a research setting. However, the value and utility of research tools gen-

erally is beyond question, even though limited to a laboratory setting. See U.S. Pat. & Trademark Off., Manual of Patent Examining Procedure (MPEP) § 2107.01 at 2100–33 (8th ed.2001, rev.Feb.2003) (“Many research tools such as gas chromatographs, screening assays, and nucleotide sequencing techniques have a clear, specific and unquestionable utility (e.g., they are useful in analyzing compounds).”). Thus, if the claimed ESTs qualify as research tools, then they have a “specific” and “substantial” utility sufficient for § 101. If these ESTs do not enhance research, then *Brenner v. Manson*, 383 U.S. 519, 86 S.Ct. 1033, 16 L.Ed.2d 69 (1966) (involving the patentability of methods for producing compounds having no known use) controls and erects a § 101 bar for lack of utility. For the following reasons, these claimed ESTs are more akin to patentable research tools than to the unpatentable methods in *Brenner*.

In *Brenner*, the Court confronted a growing conflict between this court’s predecessor, the Court of Customs and Patent Appeals (CCPA), and the Patent Office over the patentability of methods of producing compounds with no known use. This conflict began with *In re Nelson*, 47 C.C.P.A. 1031, 280 F.2d 172 (1960), the first in a series of cases wherein the CCPA reversed several Patent Office utility rejections. *Brenner*, 383 U.S. at 530, 86 S.Ct. 1033. *Brenner* put an end to these cases because, in the 1960s, the Court could not distinguish between denying patents to compounds with no known use and denying patents to methods of producing those useless compounds. The Court commented:

We find absolutely no warrant for the proposition that although Congress intended that no patent be granted on a chemical compound whose sole ‘utility’ consists of its potential role as an object of use-testing, a different set of rules

was meant to apply to the process which yielded the unpatentable product. That proposition seems to us little more than an attempt to evade the impact of the rules which concededly govern patentability of the product itself.

*Id.* at 535, 86 S.Ct. 1033. This court's predecessor later extended *Brenner* to bar patents on compounds as intermediates in the preparation of other compounds having no known use. See *In re Kirk*, 54 C.C.P.A. 1119, 376 F.2d 936 (1967) (rejecting intermediaries for steroids with no known use). These cases, however, share a common underpinning—a method of producing a compound with no known use has no more benefit to society than the useless compound itself.

This case is very different. Unlike the methods and compounds in *Brenner* and *Kirk*, Fisher's claimed EST's are beneficial to society. As an example, these research tools "may help scientists to isolate the particular underlying protein-encoding genes... [with the] overall goal of such experimentation... presumably [being] to understand the maize genome[.]" *Majority Opinion*, at 1373. They also can serve as a probe introduced into a sample tissue to confirm "that the gene corresponding to the EST was being expressed in the sample tissue at the time of mRNA extraction." *Id.*, at 1367.

These research tools are similar to a microscope; both take a researcher one step closer to identifying and understanding a previously unknown and invisible structure. Both supply information about a molecular structure. Both advance research and bring scientists closer to unlocking the secrets of the corn genome to provide better food production for the hungry world. If a microscope has § 101 utility, so too do these ESTs.

The Board and this court acknowledge that the ESTs perform a function, that they have a utility, but proceed quickly to

a value judgment that the utility would not produce enough valuable information. The Board instead complains that the information these ESTs supply is too "insubstantial" to merit protection. Yet this conclusion denies the very nature of scientific advance. Science always advances in small incremental steps. While acknowledging the patentability of research tools generally (and microscopes as one example thereof), this court concludes with little scientific foundation that these ESTs do not qualify as research tools because they do not "offer an immediate, real world benefit" because further research is required to understand the underlying gene. This court further faults the EST research for lacking any "assurance that anything useful will be discovered in the end." These criticisms would foreclose much scientific research and many vital research tools. Often scientists embark on research with no assurance of success and knowing that even success will demand "significant additional research."

Nonetheless, this court, oblivious to the challenges of complex research, discounts these ESTs because it concludes (without scientific evidence) that they do not supply enough information. This court reasons that a research tool has a "specific" and "substantial" utility *only* if the studied object is readily understandable using the claimed tool—that no further research is required. Surely this cannot be the law. Otherwise, only the final step of a lengthy incremental research inquiry gets protection.

Even with a microscope, significant additional research is often required to ascertain the particular function of a "revealed" structure. To illustrate, a cancerous growth, magnified with a patented microscope, can be identified and distinguished from other healthy cells by a properly trained doctor or researcher. But even today, the scientific community

still does not fully grasp the reasons that cancerous growths increase in mass and spread throughout the body,<sup>1</sup> or the nature of compounds that interact with them, or the interactions of environmental or genetic conditions that contribute to developing cancer. Significant additional research is required to answer these questions. Even with answers to these questions, the cure for cancer will remain in the distance. Yet the microscope still has “utility” under § 101. Why? Because it takes the researcher one step closer to answering these questions. Each step, even if small in isolation, is nonetheless a benefit to society sufficient to give a viable research tool “utility” under § 101. In fact, experiments that fail still serve to eliminate some possibilities and provide information to the research process.

The United States Patent Office, above all, should recognize the incremental nature of scientific endeavor. Yet, in the interest of easing its administrative load, the Patent Office will eliminate some research tools as providing “insubstantial” advances. How does the Patent Office know which “insubstantial” research step will contribute to a substantial breakthrough in genomic study? Quite simply, it does not.

In addition, this court faults Fisher for not presenting evidence of utility showing that the claimed ESTs “have been used in the real world.” To the contrary, this court misapprehended the proper procedure. Fisher asserted seven different utilities. The Board rejected two of these assertions outright as “insubstantial.” See *Ex parte Fisher*, App. No.2002-2046, slip. op at 14-16 (Bd. Pat.App. and Int.2004) (acknowledging that the ESTs may be able

to detect “the absence of a polymorphism” and “to isolate nucleic acid molecules of other plants and organisms[,]” but finding such utilities are not “substantial” even if the ESTs can perform them). This summary dismissal deprived Fisher of any chance to proffer evidence. Rather than fault Fisher for not presenting evidence it was prevented from offering, this court should instead observe that the Board did not satisfy its burden of challenging Fisher’s presumptively correct assertion that the ESTs were *capable* of performing those functions. See MPEP § 2107.02(IV) at 2100-40 (noting that the initial burden is on the office to establish a prima facie case as to lack of utility and to provide evidentiary support thereof); *In re Brana*, 51 F.3d 1560, 1566 (Fed.Cir.1995) (where an applicant has asserted utility in the disclosure, the Patent Office has the initial burden of challenging this presumptively correct assertion of utility).

Abandoning the proper legal procedure, the Board reasoned that the molecules studied with these ESTs showed no particular use, therefore the ESTs themselves also lacked a utility. In so ruling, the Board did not reject Fisher’s utilities on the basis that the ESTs were *unable to perform* the purported utilities. Thus, the Board did not establish a prima facie challenge to the ESTs’ ability to perform these two utilities. Without anything to rebut, Fisher had no obligation or opportunity to provide evidence in rebuttal. Thus, I respectfully disagree with this court’s conclusion that the Board’s decision can be affirmed on the basis that Fisher did not supply evidence of the ESTs’ ability to perform the asserted utilities.

In truth, I have some sympathy with the Patent Office’s dilemma. The Office needs

1. ESTs have already been used to advance cancer research well beyond what is achievable using microscopes alone. See Andy J. Minn, *Genes That Mediate Breast Cancer Me-*

*tastasis To Lung*, Nature, July 28, 2005 at 518-24 (discussing research to identify genes that mark and mediate breast cancer metastasis to the lung).

some tool to reject inventions that may advance the "useful arts" but not sufficiently to warrant the valuable exclusive right of a patent. The Patent Office has seized upon this utility requirement to reject these research tools as contributing "insubstantially" to the advance of the useful arts. The utility requirement is ill suited to that task, however, because it lacks any standard for assessing the state of the prior art and the contributions of the claimed advance. The proper tool for assessing sufficient contribution to the useful arts is the obviousness requirement of 35 U.S.C. § 103. Unfortunately this court has deprived the Patent Office of the obviousness requirement for genomic inventions. See *In re Deuel*, 51 F.3d 1552 (Fed. Cir.1995); Martin J. Adelman et al., *Patent Law*, 517 (West Group 1998) (commenting that scholars have been critical of *Deuel*, which "overly favored patent applicants in biotech by adopting an overly lax nonobviousness standard." (citing Anita Varma & David Abraham, *DNA Is Different: Legal Obviousness and the Balance Between Biotech Inventors and the Market*, 9 Harv. J.L. & Tech. 53 (1996))); Philippe Ducor, *The Federal Circuit and In re Deuel: Does § 103 apply to Naturally Occurring DNA?*, 77 J. Pat. & Trademark Off. Soc'y 871, 883 (Nov.1995) ("The Court of Appeals for the Federal Circuit could have formulated its opinion in only one

sentence: '35 U.S.C. § 103 does not apply to newly retrieved natural DNA sequences.'"); Philippe Ducor, *Recombinant Products and Nonobviousness: A Typology*, 13 Santa Clara Computer and High Tech. L.J. 1, 44-45 (Feb.1997) ("This amounts to a practical elimination of the requirement for nonobviousness for these products, even when all the information necessary to discover them is previously available."); see also over fifty additional articles critical of *Deuel* in the "Citing References" tab for *Deuel* on Westlaw. Nonetheless, rather than distort the utility test, the Patent Office should seek ways to apply the correct test, the test used world wide for such assessments (other than in the United States), namely inventive step or obviousness.

Thus, for the foregoing reasons, I would find that Fisher's asserted utilities qualify the claimed ESTs as research tools useful in the study of other molecules. Because research tools provide a cognizable benefit to society, much like a microscope, the ESTs claimed here have "utility" under § 101. In addition, the enablement rejection should also be reversed because it was a consequence of the finding of lack of utility.



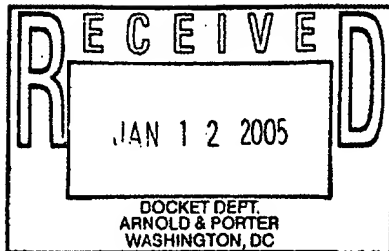
The opinion support of the decision being entered today was not written for publication and is not binding precedent of the Board.



**UNITED STATES PATENT AND TRADEMARK OFFICE**

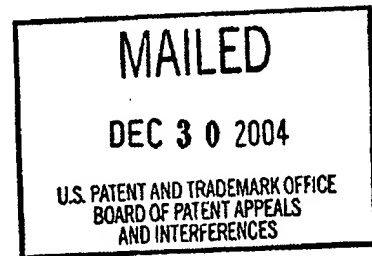
**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Ex parte JOSEPH R. BYRUM



Appeal No. 2004-1772  
Application No. 09/552,087

**ON BRIEF**



Before WILLIAM F. SMITH, ADAMS, and GREEN, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 3, 5-7, 9, 10, and 12-20, which are all the claims pending in the application.

Claims 3, 7 and 12 are illustrative of the subject matter on appeal and are reproduced below:

3. A transformed plant cell having a nucleic acid molecule which comprises:
  - (A) an exogenous promoter region which functions in said cell to cause the production of a mRNA molecule, wherein said promoter nucleic acid molecule comprises SEQ ID NO: 1 or a complement thereof; which is linked to
  - (B) a structural nucleic acid molecule encoding a protein or peptide; which is linked to



(C) a 3' non-translated sequence that functions in said cell to cause termination of transcription and addition of polyadenylated ribonucleotides to a 3' end of said mRNA molecule.

7. A transformed plant having a nucleic acid molecule which comprises:
  - (A) an exogenous promoter region which functions in a plant cell to cause the production of a mRNA molecule, wherein said promoter nucleic acid molecule comprises SEQ ID NO: 1, or a complement thereof; which is linked to
  - (B) a structural nucleic acid molecule encoding a protein or peptide; which is linked to
  - (C) a 3' non-translated sequence that functions in a plant cell to cause termination of transcription and addition of polyadenylated ribonucleotides to a 3' end of said mRNA molecule.
12. A substantially purified nucleic acid molecule, wherein said nucleic acid molecule comprises a nucleic acid sequence having between 100% and 70% identity with a nucleic acid sequence of SEQ ID NO: 1 or a complement thereof.

No prior art is relied upon in support of the examiner's position.

#### GROUND OF REJECTION

Claims 3, 5-7, 9-10 and 12-20 stand rejected under 35 U.S.C. § 101 as lacking utility and § 112, first paragraph, for lack of enablement based on the finding of lack of utility.

Claims 12-19 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification fails to provide an adequate written description of the claimed invention.

We reverse the written description rejection, and remand the application to the examiner for further consideration of the utility and enablement rejections.

## DISCUSSION

### Written Description:

The examiner rejected the claims as inadequately described, on the basis that the claimed nucleic acids

comprise SEQ ID NO: 1 or a nucleic acid related to SEQ ID NO: 1 by a particular range of identity (i.e. 100% to 80% identity, as in claim 13)<sup>1</sup>. This genus is sufficiently broad so as to encompass a multitude of variants of SEQ ID NO:1, as well as any full length coding sequence, mRNA, promoter, or genomic DNA of which SEQ ID NO: 1 is a portion, or of which the recited polynucleotides with identity to SEQ ID NO: 1 are portions. This large genus is represented in the specification by one species, a nucleic acid consisting of SEQ ID NO: 1.

Answer, bridging paragraph, pages 8-9 .

We will reverse this rejection. The written description requirement of 35 U.S.C. § 112, first paragraph, does not require a description of the complete structure of every species within a chemical genus. See Utter v. Hiraga, 845 F.2d 993, 998, 6 USPQ2d 1709, 1714 (Fed. Cir. 1988) ("A specification may, within the meaning of 35 U.S.C. § 112, ¶ 1, contain a written description of a broadly claimed invention without describing all species that claim encompasses.").

The Federal Circuit has held that "[a] description of a genus of cDNAs may be achieved by means of a recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which

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<sup>1</sup> While the examiner refers to claim 13, which depends from claim 12, we note as illustrated above, that claim 12 is broader than claim 13, in that it relates to a "sequence having between 100% and 70% identity with a nucleic acid sequence of SEQ ID NO: 1 or a complement thereof."

features constitute a substantial portion of the genus." University of California v. Eli Lilly and Co., 119 F.3d 1559, 1568, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997).

Our appellate reviewing court has also held that the complete structure of a claimed DNA is not necessarily required. The court adopted the standard that "the written description requirement can be met by 'show[ing] that an invention is complete by disclosure of sufficiently detailed, relevant identifying characteristics . . . i.e., complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics.'" Enzo Biochem, Inc. v. Gen-Probe Inc., 296 F.3d 1316, 1324, 63 USPQ2d 1609, 1613 (Fed. Cir. 2002) (emphasis omitted, alterations in original).

With respect to the claimed sequences that have 70% to 100% identity with SEQ ID NO:1, the Lilly court held that a genus could be described via "recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus." Lilly, 119 F.3d at 1568, 43 USPQ2d at 1406. The Enzo court held that such a description could take the form of "complete or partial structure, other physical and/or chemical properties, functional characteristics when coupled with a known or disclosed correlation between function and structure, or some combination of such characteristics." 296 F.3d at 1324, 63 USPQ2d at 1613. In this case, the complete structure of SEQ ID NO:1 has been described, and the nucleic acids of the claimed genus share 70 or more percent identity with the structure of SEQ ID NO:1. Thus, the structural features that are common to the genus make up 70% of the structure

of the claimed polypeptides. The examiner has not adequately explained why this degree of structural similarity is inadequate to "constitute a substantial portion of the genus," as required by Lilly.

Accordingly, we reverse the rejection of claims 12-19 under 35 U.S.C. § 112, first paragraph, as the specification fails to provide an adequate written description of the claimed invention.

Utility:

The issues of whether a disclosure satisfies the "how to use" provision of 35 U.S.C. § 112, and the utility requirement of 35 U.S.C. § 101, are closely related. See In re Swartz, 232 F.3d 862, 863, 56 USPQ2d 1703 (Fed. Cir. 2000), Process Control Corp. v. HydReclaim Corp., 190 F.3d 1350, 1358, 52 USPQ2d 1029, 1034 (Fed. Cir. 1999), Newman v. Quigg, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989). Under the utility requirement, our appellate reviewing court, has held that it makes no sense to require claims to set forth inventions that satisfy all the disclosed objectives, but that "[w]hen a properly claimed invention meets at least one stated objective, utility under § 101 is clearly shown." Raytheon Co. v. Roper Corp., 724 F.2d 951, 958, 220 USPQ 592, 598 (Fed. Cir. 1983).

As set forth in In re Langer, 503 F.2d 1380, 183 USPQ 288 (CCPA 1974), emphasis in original:

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented must be taken as sufficient to satisfy the utility requirement of Section 101 for the entire claimed subject matter unless there is reason for one skilled in the art to question

the objective truth of the statement of utility or its scope. Assuming that sufficient reason to question the statement of utility and its scope does exist, a rejection for lack of utility under Section 101 will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the statement of utility and its scope as found in the specification are true. Cf. In re Marzocchi, 58 CCPA 1069, 1073, 439 F.2d 220, 223, 169 USPQ 367, 369 (1971) (involving the enablement requirement of 35 U.S.C. 112, first paragraph).

According to the examiner (Answer, page 6), "[t]here has been no specific assertion that in fact SEQ ID NO: 1 is a promoter, aside from the claims."

Contrary to the examiner's assertion, however, appellant's specification does set forth a statement of utility that corresponds in scope to the subject matter claimed. Specifically, appellant discloses (specification, page 16), "[a]nother class of agents of the present invention are nucleic acid molecules having promoter regions or partial promoter regions, including those located within SEQ ID NO: 1...." As set forth in Raytheon, "[w]hen a properly claimed invention meets at least one stated objective, utility under § 101 is clearly shown."

Similarly, as set forth in Johns Hopkins Univ. v. CellPro Inc., 152 F.3d 1342, 1361, 47 USPQ2d 1705, 1714 (Fed. Cir. 1998), "[t]he enablement requirement is met if the description enables any mode of making and using the invention."

Therefore, it is the examiner's initial burden to establish that those skilled in this art would question the objective truth of the asserted utility. See In re Brana, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 ("Only after the PTO provides evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence."). In our opinion, the examiner has not provided sufficient evidence to

show that one of ordinary skill in the art would reasonably doubt that a nucleic acid molecule comprising SEQ ID NO: 1 would not have utility as a promoter as disclosed in appellants' specification.

To the contrary, the examiner has simply asserted (Answer, page 5) that "further experimentation would be required to reasonably confirm that SEQ ID NO: 1, or its complement, or fragments of either would function as a promoter as required by the claims. The specification does not provide any guidance as to the use of SEQ ID NO: 1, its complement or fragments thereof as promoters." Based on this assertion, the examiner concludes, "[t]he use of ... SEQ ID NO: 1 as a promoter is not a specific or substantial utility since further experimentation would be required to confirm that in fact SEQ ID NO: 1 has the ability to cause the production of an mRNA molecule...." Answer, page 6. While appellant has disclosed the characteristics of promoters within the scope of the claimed invention at pages 16-17 of the specification, the examiner fails to address this section of appellant's specification, or to establish a factual basis on this record to support the assertion that SEQ ID NO: 1 does not contain a promoter element.

According to the examiner (id.), "one would have to determine if the ... [promoter] is tissue specific or constitutive, for example, or if it is an inducible promoter, and under what circumstances it is induced or repressed in order to make use of the claimed plants." The examiner finds (id.), "[e]ach of these determinations is highly unpredictable, from the determination ... of the type of promoter it may be to the determination of fragments of the promoter that confer

promotion activity." The examiner, however, fails to establish a factual basis on this record to support these assertions.

Further, our review of this record is hindered by the examiner's failure to apply any type of claim construction to the claims now before us on appeal. In this regard, we note that claims 3 and 7, as well as the claims that depend from these claims, require in part "(A)" of each claim "an exogenous promoter region which functions ... to cause the production of a mRNA molecule." According to part "(A)" of these claims the promoter "comprises SEQ ID NO: 1 or a complement thereof...." We find no clear disclosure in the specification that SEQ ID NO: 1 is capable of functioning as a promoter region in plant cells to cause the production of a mRNA molecule. As we understand it, part "(A)" of these claims is open to at least three possible interpretations:

1. SEQ ID NO: 1 contains a promoter region which does function in plant cells to cause the production of a mRNA molecule,
2. SEQ ID NO: 1 does not contain a "promoter region," but instead contains a "regulatory element"<sup>2</sup> that acts in concert with a promoter region operably attached, either 5' or 3', to SEQ ID NO: 1, and thereby serves to regulate the expression of a mRNA molecule. For example, SEQ ID NO: 1 is an enhancer regions which is incapable of acts on a promoter, but is insufficient to function in plant cells to cause the production of a mRNA molecule on its own, or
3. SEQ ID NO: 1 contains neither a promoter region nor a regulatory element and simply serves as a filler sequence between the promoter region and a structural nucleic acid molecule, as defined in part "(B)" of these claims. For example, SEQ ID NO: 1 is incapable of functioning in plant cells to cause the production of a mRNA molecule, but instead serves only to

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<sup>2</sup> See e.g., appellant's specification, page 17.

maintain the proper distance between a promoter and a "regulatory element."

It may be that the examiner is of the opinion that SEQ ID NO: 1 does not contain a promoter element. Cf. interpretation 3 above. The examiner, however, has not provided a sufficient evidentiary basis on this record to establish that SEQ ID NO: 1 does not contain a promoter or regulatory region, or if it does, why a person of ordinary skill in the art would reasonably doubt that the sequence would not function as a promoter or regulatory region.

For the foregoing reasons we remand the application to the examiner for further consideration. Prior to any further action on the merits, we encourage the examiner to take a step back and reconsider the claimed invention together with appellant's specification and the relevant prior art. In this regard, we remind the examiner as set forth in In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), "claims must be interpreted as broadly as they reasonably, allow, in order to achieve complete exploration of applicant's invention and its relationship to prior art, so that ambiguities can be recognized, scope and breadth of language explored, and clarification imposed."

Accordingly, prior to taking any action on the record, we encourage the examiner to determine the broadest reasonable interpretation of the claimed invention and to include an analysis of this claim construction in any subsequent Office Action. If, after the examiner has evaluated the scope of the claim, the examiner believes that a rejection is necessary, the examiner should include on this record, an analysis of the claim construction together with a reasoned, fact-

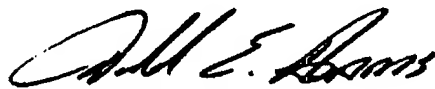


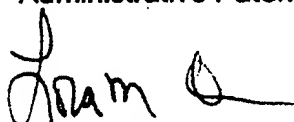
based analysis of claimed invention together with the evidence necessary to support any such rejection.

In addition, we note that appellant has disclosed and argued that a nucleic acid molecule comprising SEQ ID NO: 1 has a number of utilities, e.g., for identifying the presence or absence of a polymorphism, or as probes for other molecules or as a source for primers (see e.g., Brief, pages 7-11). These issues and arguments, however, bear a close resemblance to those presented in Ex parte Fisher, 72 USPQ2d 1020 (Bd. Pat. App. & Int. 2004) (affirming the rejection of claim 1 under 35 U.S.C. § 101 and § 112, first paragraph.). Accordingly, we encourage both the examiner and appellants to take the opportunity to reconsider their arguments on this record and to take into account the effect, if any, that Fisher may have on the issues under 35 U.S.C. § 101 and § 112, first paragraph.

REVERSED-IN-PART and REMANDED

  
William F. Smith  
Administrative Patent Judge

  
Donald E. Adams  
Administrative Patent Judge

  
Lora M. Green  
Administrative Patent Judge

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Application No. 09/552,087

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